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EXHIBIT E

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IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

Acacia Media Technologies Corp.,

Plaintiff,

vs.

New Destiny Internet Group, et al.,

Defendants.

And All Related and/or Consolidated Actions.
/

NO. C 05-01114

FURTHER CLAIM CONSTRUCTION ORDER ; ORDER FINDING CLAIMS TERMS INDEFINITE AND CLAIMS INVALID

I. BACKGROUND

In its July 12, 2004 Claim Construction Order, the Court reached a tentative conclusion that the term “sequence encoder” as used in claims 1, 7, 17, 18, 32 and 33 of the '702 patent is indefinite. This tentative conclusion of indefiniteness was based on the Court's findings from the intrinsic evidence that the term: (a) is never used in the written description; (b) does not appear in the drawings; (c) has no plain meaning, and (d) cannot be inferred to be a "time encoder," since a time encoder could be described in a dependent claim as a limitation of a sequence encoder.

In its July 12, Order, the Court also tentatively concluded that, based on the intrinsic evidence, the term "identification encoder," as used in claims 1, 5, 6, 17, 19, 27 and 31 of the '702 patent may be insolubly ambiguous because the term: (a) has no plain meaning; (b) is not defined in terms of what the apparatus is but rather how it functions; and (c) has no meaning to one of ordinary skill in the art, such that this person would understand the scope and bounds of the claim, when read in light of the specification. The Court, nevertheless, construed the claim term "identification encoder" in the '702 patent to mean "a structure that assigns a unique identification code."

The Court invited the parties to address the Court's concerns and specifically invited Plaintiff Acacia to present any extrinsic evidence on what a person of ordinary skill in the relevant art would understand the terms to mean when read in light of the patent specification.

While that invitation was outstanding, the case was placed under multi-district assignment. The Court invited all parties to submit briefs on any of the claim terms which the Court had construed. The Court reiterated its offer to Acacia to allow presentation of extrinsic evidence pertinent to the two terms tentatively found indefinite. The parties submitted briefs and declarations by proffered experts: Andrew B. Lippman and S. Merrill Weiss. On September 8 and 9, 2005, the Court conducted a hearing and the matter submitted for decision. This Order addresses the claim construction issues tendered to the Court.

II. STANDARDS

Claim construction is purely a matter of law, to be decided exclusively by the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996). Claims are construed from the perspective of a person of ordinary skill in the art at the time of the invention. Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995). To determine the meaning of the claim terms, the Court initially must look to intrinsic evidence, that is, the claims, the specification, and, if in evidence, the prosecution history. Autogiro v. United States, 384 F.2d 391 (Ct. Cl. 1967). The Court must look first to the words of the claims themselves. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). These words are to be given their ordinary and customary meaning unless it is clear from the specification and prosecution history that the inventor used the term with a different meaning. Id. The claims should be interpreted consistently with the specification. See Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

Where intrinsic evidence alone resolves any ambiguity in a disputed claim term, it is improper to rely on evidence which is external to the patent and file history. Vitronics, 90 F.3d at 1583, 1585. However, extrinsic evidence may be considered in the rare instances where the intrinsic evidence is insufficient to enable the court to construe disputed claim terms. Id. at 1585. Common sources of extrinsic evidence include expert testimony, inventor testimony, dictionaries, and technical treatises and articles. Id. at 1584.

III. DEFINITIONS CONFIRMED

The Court reaffirms its July 12, 2004, Order and lets stand its definitions of the following terms, with any modifications noted:

1. Transmission system

The Court lets stand its previous definition of "transmission system" to mean an assembly of elements, hardware and software, that function together to convert items of information for storage in a computer compatible form and subsequent transmission to a reception system.

2. Transmission system at a first location

The Court lets stand its previous definition of "transmission system at a first location" to mean a transmission system at one particular location separate from the location of the reception system.

3. Reception system at a second location

The Court lets stand its previous definition of "reception system at a second location" to mean a reception system at one particular location separate from the location of the transmission system.

4. In data communication with

The Court lets stand its previous definition of "in data communication with" to mean two or more devices connected such that data is being transferred between the devices in real time. During the September hearing, questions arose as to the meaning of "in real time" after the previous order was issued. The Court defines "in real time" to mean that the receiving system receives the data in the same electronic time frame as the transmission system sends the data.

5. Remote locations

"Remote locations" was defined in the previous order as part of the '992 patent claim construction. The Court includes the construction for the '992 patent in the '702 patent claim construction with its justification outlined in the previous order. The term "remote locations" means positions or sites distant in space from some identified place or places.

6. Transceiver

The Court lets stand its previous definition of "transceiver" to mean a singular device capable of both sending and receiving information.

IV. CLAIM TERMS TENTATIVELY FOUND INDEFINITE

The Court now addresses the terms which it tentatively concluded were indefinite.

A. The statutory requirement of definiteness.

Every patent’s specification must “conclude with one or more claims particularly point out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. This requirement is commonly referred to as the “definiteness” requirement.

As the United States Supreme Court explained in General Electric Company v. Wabash Appliance Corporation, 304 U.S. 364, 369 (1938):

> Patents, whether basic or for improvements must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. The claims measure the invention. . . . In a limited field the variant must be clearly defined.

A patent claim which fails to meet the definiteness requirement is invalid. Id., See also United Carbon Company v. Binney Company, 317 U.S. 228, 232 (1942); Default Proof Credit Card System, Inc. v. Home Depot, 412 F.3d 1291, 1302-1303 (Fed. Cir. 2005).

B. The question whether a patent claim meets the definiteness requirement is a question of law for the Court.

A determination as to whether a patent claim meets the definiteness requirement is a question of law to be decided by the court in performance of its duty as the construer of patent claims. Bancorp Services, L.L.C. v. Hartford Life Insurance Co., 359 F.3d 1367, 1371 (Fed. Cir. 2004).

An issued patent is entitled to a statutory presumption of validity. 35 U.S.C. § 282. A patent claim is indefinite only if, under these canons of construction, the court finds that one skilled in the art would not understand what is claimed when the claim is read in light of the specification. Personalized Media Communications, Inc. v. Int'l Trade Comm'n, 161 F.3d 696, 705 (Fed. Cir. 1968). If the Court is able to determine a reasonable, unambiguous meaning of the terms of a claim, as those terms would be understood by a person of skill in the art in light of the specification, even though the task is formidable and the conclusion is one over which reasonable people disagree, the claim is not indefinite. Bancorp Services, L.L.C., 359 F.3d at 1371; see also Datamize, L.L.C. v. Plumtree Software, Inc., 417 F.3d 1342, 1347-1348 (Fed. Cir. 2005).

A determination of definiteness is made based upon proper interpretation of the meaning of the terms used in the claim, according to the canons of claim construction. Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1340-41 (Fed. Cir. 2003). Under those canons, interpreting the meaning of the terms begins with a review of the intrinsic evidence–the claims, other parts of the specification, and the prosecution history. Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996); Datamize, L.L.C., 417 F.3d at 1348.

The claim terms are generally given their ordinary and customary meaning. If a technical term is used in a patent claim, generally, the term should be interpreted as having the meaning a person experienced in the field of the invention would give to it. See Verve, L.L.C. v. Crane Cams Inc., 311 F.3d 1116, 1119 (Fed. Cir. 2002). Testimony by a witness, who is recognized by the Court as an expert in the field of the invention, about the common meaning of a technical term at the time the application was filed, is instructive in ascertaining its meaning. See Glaxo Wellcome, Inc. v. Andrx Pharm., Inc., 344 F.3d 1226, 1229 (Fed. Cir. 2003); Optical Discorp v. Del Mar Avionics, 208 F.3d 1324, 1334 (Fed. Cir. 2000).

C. The Claims of the '702 Patent.

Claim 1 of the '702 patent claims:

> 1. A communication system comprising:
> a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises
> **a sequence encoder**,
> **an identification encoder**, and
> a compressed data library in data communication with **said identification encoder**,
> wherein **said identification encoder** gives items in said compressed data library a unique identification code; and
> wherein said reception system comprises
> a transceiver in data communication with said transmission system,
> a storage device in data communication with said transceiver,
> user playback controls in data communication with said storage device,
> a digital compressor in data communication with said storage device, and
> a playback device in data communication with said digital decompressor.

('702 patent, 19:26-47.)

D. "Sequence encoder."

1. The term "sequence encoder" has no ordinary and customary meaning.

In addition to Claim 1, the term "sequence encoder is also used in Claims 7, 17, 18, 32 and 33 of the '702 patent. In its tentative conclusion, the Court determined that the term "sequence encoder" had no ordinary and customary meaning in the field of the invention.

Initially, Acacia objected to that conclusion.[1] However, at the September 2005, hearing, Acacia tendered Mr. S. Merrill Weiss as an expert witness on how persons of ordinary skill would understand the terms used in the '702 patent claims and specification in 1991.

Mr. Weiss opined that the field of the invention disclosed in the '702 patent was “system design” in the broadcast television industry. (TR. 18:23-25, 19:1-1.) Mr. Weiss opined that he had a sufficient background to express an opinion on the education and experience of a person skilled in that field in 1991. In that regard, Mr. Weiss testified that one skilled in system design in the television broadcast industry was one who had a Bachelor of Science degree in electrical engineering, computer science or computer engineering or the equivalent in experience in the broadcast television industry. (TR. 43.)

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[1]Acacia contended that an encoder is "a device or system that encodes data." Acacia asserted that a "sequence encoder" is "an encoder which creates a sequence."

Specifically, with respect to whether the term “sequence encoder” had an ordinary and customary meaning to one skilled in system design in the television broadcast industry, Mr. Weiss testified:

> Q. In 1991, did the term “sequence encoder” have an ordinary meaning to one of ordinary skill in the art?
>
> A. No.
>
> * * *
>
> Q. In 1991, would the term “sequence encoder” have been a term of art to one of ordinary skill in the art?
>
> A. No.
>
> * * *
>
> Q. Are you aware of any dictionary in 1991 where it would have defined the term “sequence encoder”?
>
> A. No.

(TR. 64-65.)

Accordingly, the Court confirms its tentative finding that the term "sequence encoder" is a technical term which had no ordinary and customary meaning in the field of the invention at the time the patent was filed.

2. "Sequence encoder" is a coined technical term which is not expressly defined.

A patentee is free to act as his or her own lexicographer. Acting as lexicographer, the patentee may either define a term used in a claim differently from its ordinary meaning or coin a new term. However, if the patentee chooses to act as his or her own lexicographer, the special definition must be clearly stated within the patent specification or file history. Vitronics Corp., 90 F.3d at 1582.

Acacia now acknowledges that the term is a "coined term," meaning that the patentee made up the term acting as lexicographer. However, there is no clear statement of definition of the coined term "sequence encoder" in the specification or file history. Indeed, as the Court noted in its July 12 Order, other than in the claims themselves, the term "sequence encoder" is never used in the specification of the '702 patent and was never used or referred to in the prosecution of the '702 patent.

If a patentee uses a coined technical term as an element of a claim and fails to clearly define the term elsewhere in the specification or prosecution history, the meaning of the term is left to speculation and subjective judgment. A patent claim, which includes as an element a term, the meaning of which is left to speculation and subjective judgment, is indefinite.

To avoid an ultimate finding of indefiniteness, Acacia contends that, although the term is not expressly defined in the specification, a person skilled in the art would infer a meaning for the term "sequence encoder" from the description in the specification of other devices. Specifically, Acacia contends that one skilled in the art would infer that by "sequence encoder" the patentee meant "a time encoder."

3. A patent claim is not indefinite if based on the specification, a meaning for an otherwise undefined term can be inferred from the specification.

Acacia directs the Court to two decisions of the Federal Circuit which it asserts as authority for a methodology of defining coined claim terms that have no meaning in the art and are not referred to in the specification: Bancorp Services L.L.C. v. Hartford Life Insurance Co., 359 F.3d 1367 (Fed. Cir. 2004) and Network Commerce, Inc. v. Microsoft Corp., 422 F.3d 1353 (Fed. Cir. 2005).

In Bancorp a patent describes a system for administering and tracking the value of life insurance policies in separate accounts. Bancorp Services, 359 F.3d at 1369. The independent claims used the term "surrender value protected investment credits." Except for use in the claims themselves, the term was not used in the patent. The trial judge found the term to be unclear in meaning as to render the patent claims invalid. Bancorp argued that the challenged term meant the same as "stable value protected investment," a term which was commonly understood in the insurance field and which was used and defined in the specification. Id. at 1370. On appeal the Federal Circuit agreed with Bancorp that based on the specification the terms were equivalent to one another. Id. at 1373. Thus, Bancorp Services stands as authority that the failure to define a term is not fatal if the meaning of the term can be fairly inferred from terms in the specification which were commonly used in the field and which those of skill in the industry regarded as synonymous.

In Network Commerce the term "download component" was used in the claims. Network Commerce, 422 F.3d at 1357. It was found to be a term which had no commonly understood meaning nor one with a specialized meaning in the field of the invention. However, the Federal Circuit gave a definition to the term based on the specification. The claims stated how the "download component" functioned in the claimed method. The Circuit Court relied on references to "download file" in the specification to define "download component." Id. at 1360-1361.

This Court notes that Network Commerce is not a case where the claim was being reviewed to determine if it met the "definiteness" requirement. The issue in Network Commerce was whether or not the definition of the term should include a "boot program" which interacts with the operating system of the computer. The Circuit held that it did:

> In summary, the specification makes clear that the download component must include a boot program, and that the boot program interacts directly with the operating system of the computer without the assistance of any other program. Accordingly, we construe "download component to mean...

Id.

Acacia is correct, however, that in both cases, the Federal Circuit gave definition to a coined term which was not expressly defined in the specification. However, in both cases, the Federal Circuit relied on the intrinsic language of the patent specification to construe the meaning of the subject terms. The question in this case becomes whether based on the specification of the '702 patent, it can be reasonable inferred that the term "sequence encoder" means "time encoder."

4. A "time encoder" is referred to in the specification.

The term "time encoder" is itself a coined technical term with no ordinary and customary meaning to one skilled in the field of system design at the time the '702 patent was filed. Mr. Weiss, though, testified that in his opinion a “time encoder” was essentially a “time code generator,” which was known at the time of the invention (TR. 173:23-25.)

The Court considered the device called "time encoder" when the Court defined the term "ordering means" in construing the '992 patent. The '702 patent shares the same specification as the '992 patent. With respect to "time encoder," the specification states:

> The transmission system 100 of the present invention also preferably includes ordering means for placing the formatted information into a sequence of addressable data blocks. As shown in FIG. 2a, the ordering

> means in the preferred embodiment includes time encoder 114. After the retrieved information is converted and formatted by the converter 113, **the information may be time encoded by the time encoder 114. Time encoder 114 places the blocks of converted formatted information from converter 113 into a group of addressable blocks.** The preferred addressing scheme employs time encoding. Time encoding allows realignment of the audio and video information in the compressed data formatting section 117 after separate audio and video compression processing by precompression processor 115 and compressor 116."

('702 patent, 7:50-64.)

From this and other references in the specification, the Court finds that the "ordering means" may include a " time encoder" which is a device that can be used in a preferred embodiment of the claimed "transmission system." If a "time encoder" is used as part of the ordering means, its function is to place blocks of converted data into a "group of addressable data blocks." The "time encoder" uses "time encoding" to do so. There is nothing in the specification which discloses that the "time encoder" can encode any sequence other than "time." Thus, to give "sequence encoder" the definition of the "time encoder disclosed in the specification" would limit the "sequence encoder" to encoding "time" as the only sequence it is capable of encoding.

5. There is no suggestion in the specification that "time" is the only "sequence" which could be used to practice the invention.

There is nothing in the specification of the '702 patent which supports the contention that the patentee intended time to be the only encodable sequence.

If a patentee uses a broad undefined term (such as "sequence encoder") in claiming an invention, when the validity of the patent is called into question in a legal proceeding, the owner of the patent cannot avoid invalidity by adopting a more limited definition (such as "time encoder"), unless that limitation can be fairly inferred from the specification.

Mr. Weiss opined that, since the patent is "fundamentally" about audio and video information and since such information is naturally processed and stored using time, a person of ordinary skill in the art would understand "sequence encoder" to be a "time encoder:"

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Q. Now, if as you said earlier without regard to any part of the patent the term "sequence" can mean any sequence and not necessarily a time sequence, why would a person of ordinary skill in the art understand the term "sequence encoder" to be a time encoder rather than some other encoder in the context of this patent?

A. Because this patent is fundamentally about video and audio processing and storage and handling and the natural way that video and audio are, are – their inherent structure is along a time line. They are naturally divided by – into time.

(TR. 161:2-13.)

However, on cross-examination, Mr. Weiss acknowledged that, based on the specification, time was not the only natural sequence for organizing the type of data covered by the invention:

Q. And so you agree that as of the time of the filing of the patent application in January of 1991 packets of data were organized and in sequences that were unrelated to time?

A. I think you last said they could be and yes they could be.

Q. And they actually were; correct?

A. In some applications they were.

(TR. 210:9-16.)

Later, in his testimony, Mr. Weiss acknowledged that a "time encoder" was only "one example" of the broader term "sequence encoder." (TR. 225:10-14.) He stated his opinion that the terms were synonymous was based on a process of elimination. In other words, since a "time encoder" and an "identification encoder" were the only encoder mentioned in embodiments of the invention, by process of elimination, Mr. Weiss drew the conclusion that the "sequence encoder" meant the "time encoder." Mr. Weiss' testimony went beyond the bounds of his expertise. The Court rejects his methodology.

Furthermore, it is fundamental that while the specification should be consulted to obtain an understanding of a claim, the limitation of a preferred embodiment disclosed in the specification is not to be read into a claim, unless reading the limitation in is required by the language of the claim. As the Federal Circuit observed in Phillips v. AWH Corp., "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments." 415 F.3d 1303 at 1323 (Fed. Cir. 2005). There are notable exceptions to the rule for not limiting the claim to a preferred embodiment, such as when the preferred embodiment is described in the specification as the invention itself. In other words, where the patentee describes an embodiment as being the only way of utilizing the invention, it is permissible to limit the claim to the embodiment.

In this case, given the types of materials which can be transmitted in practicing the invention (books, photographs, musical instruments and other items–digitized for transmission) from the specification, there is no basis for the Court to conclude that "time" is the only sequence which one skilled in the art would have used in 1991 to practice the invention.

6. To import into "sequence encoder" the definition "time encoder" as disclosed in the specification would be importing a limitation which the patentee expressly did not import.

Accepting Acacia‹s definition of "sequence encoder" would violate the doctrine of claim construction, called "claim differentiation."[2]

In deciding the scope of a claim, the Court is obliged to consider the other claims in the patent. Howes v. Medial Components, Inc., 814 F2d 638, 643 (Fed. Cir. 1987); Moeller v. Ionetics, Inc., 794 F2d 653, 656 (Fed. Cir. 1986). Under the doctrine of "claim differentiation," the presence of limitations in narrow claims is evidence that these limitations are not to be read into a broader claim. The patentee is entitled both to a narrow claim particularly directed to a preferred embodiment described in the specification and to a broad claim which defines the invention without reference to those details. The presence of the narrow claim negates limiting the broad claim to the preferred embodiment. The presence of a specific limitation in one claim gives special significance to the absence of that specific limitation in another claim, in that it shows that when the limitation was intended it was expressed. Hoganas AB v. Dresser Indus., Inc., 9 F.3d 949, 950 (Fed. Cir. 1993) (quoting E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988); SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1122 (Fed. Cir. 1985).

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[2]The Court has previously considered and rejected Acacia's argument that "sequence encoder" should be defined as the time encoder disclosed in the specification. The Court reconsiders its ruling in light of the briefs and testimony presented at the September hearing.

In this case, dependent claim 7 reads:

> A communication system as recited in Claim 1**, wherein said sequence encoder transforms digital data blocks into a group of addressable data blocks**.

The Court has construed the apparatus which transforms digital data blocks into a group of addressable data blocks to be the "time encoder," which is part of the ordering means. The same terms should be given the same meaning in all of the claims, unless it is clear from the specification that the terms have different meanings. Fin Control SYS. Pty. v. AM, Inc., 265 F.3d 1311, 1318 (Fed. Cir. 2001). Based on their common function, the Court finds that "sequence encoder that transforms digital data blocks into a group of addressable data blocks" in claim 7 is the same device as the one described in the specification as part of the ordering means called the "time encoder," which transforms the data into a "group of addressable blocks," employing "time" as the preferred addressing scheme.

Claim 1 differs from claim 7 it that it does not limit the sequence encoder to one which transforms digital data blocks into a group of addressable data blocks nor is it limited to using time as the preferred addressing scheme. Therefore, claim 1 is broader than the sequence encoder disclosed in claim 7. The sequence encoder in claim 1 could possibly be the ordering means and the structure in claim 7 could possibly be the time encoder.[3] Hence, the Court cannot infer that the "sequence encoder" is a "time encoder" as that term is used in the patent specification.

The Court examined Bancorp Services and Network Commerce to see if those cases involved claim differentiation issues. In those decisions, the Federal Circuit did not address whether an unlimited element in an independent claim should be given a definition which would import the sole limitation of a dependent claim. Therefore, those cases are not authority for construing the subject patent.[4]

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[3]The "sequence encoder" in claims 7 could be construed to read on the "ordering means" in the written description. This is consistent with the testimony of Mr. Weiss, where he said that other encoding schemes, besides time encoding, may be used in the system (TR. 212:20-24, 224-225.) These other encoding schemes would be necessitated by source library items that contained other than audio/video information, like books or violins. There may also be other functions associated with the ordering means. Mr. Weiss said that he would have known how to build a time encoder, since time encoding techniques were well known in 1991 (TR. 174.) However, it would not have been obvious how to build the "ordering means," since the written description does not fully specify all the functions nor does it teach any structure for the "ordering means" from which such functions could be deduced.

However, upon reconsideration the Court limits its finding of indefiniteness to the independent claims 1, 17 and dependent claim 32. Dependent claims "shall be presumed valid even though dependent upon an invalid claim." 35 U.S.C. § 282. The Court leaves for later consideration upon motions by the parties whether or not the limitations in dependent claims 7, 18 and 33 provide additional information about "sequence encoder" to allow the Court to define it and to satisfy the definiteness requirement.

7. There is a lack of indication of a cooperative relationship between the "sequence encoder" and the other elements of the claim.

Patents claiming a system, are indefinite under §112 if the claim does not recite structural relationships of essential elements. See In re Collier, 397 F.2d 1003 (C.C.P.A. 1968). If the system is one for which the relationship of elements is conventional and commonly known, the Court can take notice of a relationship, even if one is not stated. However, when the element is not known in the field of invention, the claim must specify the relationship.

Claims 1 and 32 of the '702 patent disclose a communication system, comprising a transmission system and a reception system. The "sequence encoder" is disclosed as an element of the transmission system. Unlike other elements of claims 1 and 32,[5] the term "a sequence encoder" omits disclosure of a cooperative relationship with the other elements. There is no specification of its input or its output. This omission is particularly troublesome because as a coined term which is not defined, there is no way to determine a relationship.

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[4]The Court also considered Masami Corp. v. Mallinckrodt, Inc., 18 Fed. Appx. 852 (Fed. Cir. 2001), where the court found "adaptive filter" and "adaptive signal processor" to mean an "adaptive noise canceler." The latter term was used interchangeably with the other terms during the prosecution of the patent and in dependent claims. No such interchangeable use is involved in this case.

[5]Claim 7 also lacks an express relationship between the "sequence encoder" and the other elements. The term "in data communication with" is lacking. However, if the "sequence encoder" in Claim 7 is equated with the "time encoder," the specification shows a relationship.

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For the Northern District of California

Thus, an additional basis for indefiniteness of claims 1 and 32 is the lack of a disclosed cooperative relationship between the "sequence encoder" and the other elements leaves a gap between essential structural connections.[6]

E. "Identification encoder."

1. The term "identification encoder" is a coined technical term which is ambiguous.

The Court confirms its tentative finding that the term "identification encoder" had no ordinary and customary meaning to one skilled in the art at the time of the invention. Mr. Weiss, Acacia's expert witness on the meaning of the term, testified that "identification encoder" had no ordinary meaning to one skilled in the art. (TR. 64:18-21.)

Since the term has no plain meaning, the Court looks to the patent specification to see if the patentee defined the apparatus. Unlike the "sequence encoder," the written description contains references to "identification encoder." Among others, the written description contains the following references to unrelated preferred functions of the "identification encoder" occurring at various unspecified times in the transmission system:

1. The identification encoder 112 gives a unique identification code to items stored in a compressed data library (6:34-35);
2. Performs storage encoding (giving the item a unique identification code, optionally logging details about the item, called program notes, and assigning the item a popularity code) just prior to conversion of the item for transmission to reception system, at any item after starting the conversion process, or after storing the item in the compressed data library (6:34-42);
3. Preferably assigns: a unique identification code, a file address, a popularity code and input program notes (6:43-48);
4. Inputs digital signal to digital input receiver (6:62-64);

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[6]As shown in claims 17 and 18, the patentee was capable of specifying a relationship between the "sequence encoder" and other claim elements if there are any.

5. Inputs analog signal to analog-to-digital converter (7:6-8);

6. Passes previously compressed items directly to the compressed data library (7:36-41);

7. Allows entry of item notes and production credits (10:45-51);

8. Maps item addresses to item names as an alternative method of accessing items (10:52-53);

9. Operates a program which updates a master item database containing facts regarding items in the compressed data library system (10:56-59);

10. Generates a unique address code which makes access to the requested data possible (10:43-44).

As the Court stated in its July 12 Order, although some of the functions of the "identification encoder" are set out, there is no description of a structure which performs those functions. Apparatus claims cover what a device is, not what a device does. See Hewlett Packard Co. v. Bausch & Lomb, Inc., 909 F.2d 1464, 1468 (Fed. Cir. 1990). Figure 2a contains a block diagram designated "112" and labeled "IDENTIFICATION ENCODING PROCESS." A label entitled "Encoding Process" is more indicative of a method claim than it is of an apparatus claim. Indeed, the '992 patent, which is based on the same specification as the '702 patent, contains a method claim 41 which discloses identification encoding not as an apparatus, but as a step in a method:

> 41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:
> storing items having information in a source material library;
> retrieving the information in the items from the source material library;
> **assigning a unique identification code to the retrieved information**;
> placing the retrieved information into a predetermined format as formatted data;
> placing the formatted data into a sequence of addressable data blocks;
> compressing the formatted and sequenced data blocks;
> storing as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
> sending at least a portion of the file to one of the remote locations.

('992 24:54-25:5)

Notwithstanding the "process" label, based on the written description the Court finds that block "112" is a diagram of what the patentee meant by "identification encoder." However, the references to block 112 in the specification do not assist the Court in defining what an "identification encoder" is. All that the specification does is to describe what the "identification encoder" preferably must do. The specification does not disclose a circuit, a computer operating a software algorithm, or other apparatus which performs the functions designated for the "identification encoder."

Under certain circumstances, it may be permissible to claim invention of an apparatus and include in the specification only a block diagram along with a description of some of its functions. However, this method of claiming an apparatus is only permissible if the device is a conventional one, such that a person of ordinary skill would readily understand what the device is. Claiming an apparatus using only a block diagram with functional description is indefinite when the patentee names the device using a coined term and the various functions could be performed by an indefinite variety of devices.

Acacia's expert witness, Mr. Weiss, testified:

> Q. Does the '702 patent identify any single structure for identification encoder?
> A. No, it does not.
> Q. Does the '702 patent require any single structure for identification encoder?
> A. Does it require? No, it does not.

(TR. 146:10-15.)

* * *

> Q. Take a look at column 6, line 39 through 42. What else, if anything, would the hypothetical person of ordinary skill have understood about the identification encoder from reading that portion of the specification?
> A. . . .that the identification encoder could similarly be located at any of those places in the system.

(TR. 93:5-18.)

At one point, Mr. Weiss stated that the only non-optional function of the "identification encoder" was "assigning a unique identification code." His stated assessment was based on the wording of the patent description. On the basis of Mr. Weiss' opinion, Acacia contends that the only function to be included in the construction of "identification encoder" is assignment of a unique identification code. The Court, however, must also include functions which may be worded as optional, but which would render the invention inoperable were they not included. If the Court did not do so, the patent would have no utility. Indeed, at another point in his testimony, Mr. Weiss disagreed with the "only non-optional function" analysis, stating that one would have to list other functions of the "identification encoder." (TR. 291-293.)

The Court confirms its earlier conclusion that at the time of the invention, one of ordinary skill in the art would not understand the scope or bounds of the structure of the term "identification encoder" when that term is read in light of the specification, rendering the claim term "identification encoder" indefinite. In its July 12 Order, the Court defined the term by using its nonspecific function—encoding an identification—and defined it as an apparatus for performing that function. The Court now concludes that this functional definition is insufficient to comply with the requirement of definiteness. The Court finds "identification encoder" indefinite and on that basis finds claims 1, 17 and 27 invalid. As with the "sequence encoder," the Court leaves for later consideration the affect of this finding on dependent claims.

V. CONCLUSION

The Court concludes that the claim term "sequence encoder" is indefinite and renders independent claims 1, 17 and dependent claim 32 of the '702 patent invalid. The Court reserves for later proceedings whether the invalidity of claims 1 and 17 affect the validity of each claim which depend from these claims. 35 U.S.C. § 282.

The Court concludes that the claim term "identification encoder" is indefinite and renders independent claims 1, 17 and 27 of the '702 patent invalid. The Court also reserves for later proceedings whether the invalidity of the independent claims affect the validity of claims which depend from them.

The Court invites any party desiring to file motions based on this Order to do so in accordance with the Local Rules of the Court. The Court also invites the parties to tender to the Court requests for construction of other terms. To accommodate potential motions and further claim construction proceedings, the Court specially sets a hearing on **February 24, 2006 at 9:00 a.m.** to hear any such motions. If no motions are filed, the parties are ordered to appear on that date at **10:00 a.m.** for a case management conference. In advance of the scheduled proceedings, the Court will advise the parties of the matters which it will consider and what pre-conference submissions are required.

Dated: December 7, 2005

JAMES WARE
United States District Judge

THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:

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Dated: December 7, 2005 **Richard W. Wieking, Clerk**

By: /s/ JW Chambers
Ronald L. Davis
Courtroom Deputy

EXHIBIT F

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

Acacia Media Technologies Corp., Plaintiff, vs. New Destiny Internet Group, et al., Defendants.	NO. C 05-01114
And All Related and/or Consolidated Actions. /	**THIRD CLAIM CONSTRUCTION ORDER**

I. BACKGROUND

This is the Third Claim Construction Order in this Multi-District Litigation case in which Plaintiff, Acacia Media Technologies Corporation, asserts infringement involving the Yurt's family of patents entitled, "Audio and Video Transmission and Receiving System ('992, '275, '863, '720, and '702).

On July 12, 2004, the Court issued its First Claim Construction Order. (hereafter, the "July 12 Order," filed in SA CV 02-1040-JW (MLGx).)

On December 7, 2005, the Court issued its Second Claim Construction Order. (hereafter, the "December 7 Order," Docket Item No. 119.)

The Court held further claim construction hearings on June 14 and 15, and September 7 and 8, 2006. This Order gives the Court's construction of disputed terms in the '992 and '275 Patents which were the subject of the June and September hearings. The Patents which are not addressed in this Order will be subject of a subsequent Order.

II. WITHDRAWN CLAIMS

During the June and September hearings, the parties advised the Court that Acacia is withdrawing from assertion the following Claims of the '992 Patent: 1-18, 23-40, and 47-58. The parties represented that a formal stipulation of withdrawal will be filed with the Court. In view of the tendered withdrawal of those Claims, the Court will not give further consideration to construing them, unless the Court finds it necessary to do so to construe a Claim which remains in contention.

III. STANDARDS

Claim construction is purely a matter of law, to be decided exclusively by the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996). Claims are construed from the perspective of a person of ordinary skill in the art at the time of the invention. Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995). To determine the meaning of the claim terms, the Court initially must look to intrinsic evidence, that is, the claims, the specification, and, if in evidence, the prosecution history. Autogiro v. United States, 384 F.2d 391 (Ct. Cl. 1967). The Court must look first to the words of the claims themselves. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). These words are to be given their ordinary and customary meaning unless it is clear from the specification and prosecution history that the inventor used the term with a different meaning. Id. The claims should be interpreted consistently with the specification. See Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

Where intrinsic evidence alone resolves any ambiguity in a disputed claim term, it is improper to rely on evidence which is external to the patent and file history. Vitronics, 90 F.3d at 1583, 1585. However, extrinsic evidence may be considered in the rare instances where the intrinsic evidence is insufficient to enable the court to construe disputed claim terms. Id. at 1585. Common sources of extrinsic evidence include expert testimony, inventor testimony, dictionaries, and technical treatises and articles. Id. at 1584.

The Federal Circuit has consistently employed the caveat, "if possible," to their instruction that claims should be construed to sustain their validity. Rhine v. Casio, Inc., 183 F.3d 1342, 1345, (Fed. Cir. 1999) (citing Whittaker Corp. v. UNR Indus., Inc., 911 F.2d 709, 712 (Fed. Cir. 1990)). At the same time, the Federal Circuit has admonished against judicial rewriting of claims to preserve validity. Rhine, 183 F.3d at 1354 (citing Becton Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 799 & n. 6 (Fed. Cir. 1990)).

IV. DISCUSSION

I. THE '992 PATENT

A. The '992 Patent - Claim 19

Claim 19 of the '992 Patent provides:[1]

> A distribution method responsive to requests from a **user** identifying **items** in a transmission system **containing information** to be sent from the **transmission system** to **receiving systems** at **remote locations**, the method comprising the steps of:
>
> storing, in the transmission system, **information from items** in a compressed data form, the information including an identification code and **being placed into ordered data blocks**;
>
> sending a request, by the user to the transmission system, for **at least a part of the stored information** to be transmitted to one of the receiving systems at one of the **remote location selected by the user**;
>
> sending **at least a portion of the stored information** from the transmission system to the receiving system at the **selected remote location**;
>
> receiving the sent information by the receiving system at the **selected remote location**;
>
> storing a complete copy of the received information in the receiving system at the **selected remote location**; and
>
> **playing back the stored copy of the information using the receiving system** at the **selected remote location** at a **time requested by the user**.

[1] Unless otherwise indicated, all bold typeface is added by the Court to emphasize the terms and phrases under consideration.

United States District Court
For the Northern District of California

1. The Preamble of Claim 19

Before construing the words and phrases of the elements of Claim 19, the Court considers whether the Preamble is limiting.

The Preamble of Claim 19 provides:

> A distribution method responsive to requests from **a user** identifying items **in a transmission system** containing information to be sent from **the transmission system** to **receiving systems** at remote locations, the method comprising the steps of...

Generally, the preamble does not limit the claims. Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, (Fed. Cir. 2002) (citing DeGeorge v. Bernier, 768 F.2d 1318, 1322 n. 3 (Fed. Cir. 1985)). However, if a preamble is used as an antecedent, namely, to define the apparatus which performs the claimed invention, it is limiting. Allen Eng'g Corp., 299 F.3d at 1346 (citing Bell Comm. Research, Inc. v. Vitalink Comm. Corp., 55 F.3d 615, 620 (Fed. Cir. 1995)). In addition, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." Catalina Marketing International Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002) (citing Bristol-Meyers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368 (Fed. Cir. 2001)).

The Court finds that the Preamble of Claim 19 is limiting for two reasons. First, the Preamble of Claim 19 is antecedent to the claims in that it requires the distribution method be performed by a "transmission system" and a "receiving system," in response to requests from a "user." Multiple claim elements refer to "the transmission system," "the receiving system," and "the user" based upon the Preamble. Second, the prosecution history of the '992 Patent shows that the Preamble of the claim which was eventually numbered Claim 19 was amended by the applicants to avoid prior art: (the additions are underscored)

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of: . . .

//

(Round 3 Defendants' Claim Construction Brief - Part I at 8, Docket Item No. 159; Declaration of David Benyacar, hereafter, "Benyacar Decl.," Ex. F at 2, Docket Item No. 161.) The applicants confirmed in their accompanying remarks that the amendments were made to ". . . reflect that the distribution method recited in these claims involves both a transmission system and receiving system at a remote location, and that the received information is stored as a complete copy in the receiving system at the remote location." (Benyacar Decl., Ex. F at 12.) This amendment was made at the examiner's direction to overcome the previous rejections. (Id.)

The Court finds that the **Preamble of Claim 19 of the '992 Patent** is limiting as follows:

> **Based upon the Preamble of Claim 19 of the '992 Patent, the distribution method disclosed in Claim 19 of the '992 Patent must be performed by a "transmission system" having items containing information, which information is to be sent to "receiving systems" at remote locations in response to requests from a "user" identifying items.**

2. The Order of the Steps of Claim 19

It is undisputed that the steps of the elements of Claim 19 must be performed in the order that they appear in the claim. However, there is a dispute over whether each step must be completed before a subsequent step may commence. Each step of Claim 19 is antecedent to each succeeding step. It is inherent in the meaning of "antecedent" that a step of a method, which is antecedent to another step, must commence before the succeeding step commences, and it must finish before the succeeding step can finish. Therefore, the Court finds that each step need not be completed before a subsequent step may commence.

3. "transmission system"

The Court addresses the definition of the phrase "transmission system" because it is a limitation on the method disclosed in Claim 19.

The parties dispute the proper construction of the phrase, "transmission system" as previously defined by the Court and as used in Claim 19. In the July 12 Order, the Court construed the phrase "transmission system," as it is used in apparatus Claims 1, 17 and 27 of the '702 Patent and in Claims 1-18 of the '992 Patent. Based on the arguments in the briefs and presentations made during the June and September hearings, the Court reconsiders its definition of "transmission system."

When the meaning of a term is sufficiently clear in the patent specification, that meaning shall apply. Multiform Desiccants, Inc. v. Medzam, LTD., 133 F.3d 1473, 1477 (Fed. Cir. 1998) (citing Intellical, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388 (Fed. Cir. 1992)). "This rule of construction recognizes that the inventor may have imparted a special meaning to a term in order to convey a character or property or nuance relevant to the particular invention. Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." Multiform Desiccants, Inc., 133 F.3d at 1477.

In the July 12 Order, the Court treated "transmission system" as a term with a special meaning, namely, "an assembly of elements, hardware and software, that function together to convert items of information for storage in a computer compatible form and subsequent transmission to a reception system." (July 12 Order at 27-28.) The Court's July 12 definition recognizes that by "transmission system" the patentee meant something more than an apparatus which "transmits." The Court finds that the definition given in the July 12 Order recognizes some but not all of the components of what the patentee meant by the phrase "transmission system."

The phrases "transmission system" and "reception system" are coined terms. The inventions disclosed in the '992 Patent are audio and video transmission and receiving apparatuses and methods which operate over conventional communication channels, but ones in which a user remotely controls what material is transmitted and when it is played back. To accomplish this objective, the patentee disclosed an apparatus with interconnected components for preparing the audio and video information for user access and transmission, which the patentee coined as a "transmission system."

When the patentee acts as his or her own lexicographer, the court looks to the intrinsic evidence for a definition of the words and phrases used in a claim. Vitronics Corp., 90 F.3d at 1582. In the specification of the '992 Patent, the patentee defines the components of the "transmission system" as follow:

> To achieve the objects in accordance with the purposes of the present invention, as embodies and described herein, the **transmission** . . . **system** for providing information to remote locations comprises **source material library means** prior to identification and compression; **identification encoding means** for retrieving the information for the items from the source material library means and for assigning a

> unique identification code to the retrieved information; **conversion means**, coupled to identification encoding means, for placing the retrieved information into a predetermined format as formatted data; **ordering means**, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks; **compression means**, coupled to the ordering means, for compressing the formatted and sequenced data; **compressed data storing means**, coupled to the compression means, for storing as a file the compressed sequenced data received from the compression means with the unique identification code assigned by the identification encoding means; and **transmitter means**, coupled to the compressed data storing means, for sending at least portion of a specific file to a specific one of the remote locations.

('992 Patent, Col. 2:25-48.)

In specifying the components of "transmission system" the patentee uses a "structural tag plus means." Under this format, once a given means-plus-function component is introduced, the patentee may make subsequent references to the same structure by using the structural "tag" followed by the word "means," e.g., "After compression processing by compressor 116, the compressed audio and/or video data is preferably formatted and placed into a single file by the **compressed data storage means 117**." ('992 Patent, Col. 10:24-26). An apparatus claim which is in mean-plus-function format is limited to the corresponding structure in the specification and its equivalents. A method claim containing a preamble which requires that the steps be performed by an apparatus, is limited to that apparatus and any other apparatus identified in the specification for performing the specified step. Claim 19 is limited to the "transmission system" and "receiving system" disclosed in the specification.

In the July 12 Order, the Court defined some of the structures of the components of the "transmission system." Incorporation of those structures does not import preferred embodiments into a claim. The "transmission system" and "receiving system" and methods for using them to distribute audio and video information as described in the specification are the inventions in the '992 Patent. They are not preferred embodiments; they are the inventions themselves. When the embodiment is described as the invention itself, the claims are not entitled to a broader scope than the embodiment. Modine Manufacturing Co., v. United States International Trade Comm., 75 F.3d 1545, 1551 (Fed. Cir. 1996) (abrogated on other grounds by Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000), rev'd by 535 U.S. 722 (2002)).

The specification includes drawings of the "transmission system" described as follows:

> FIGS. 1a - 1g are high level block diagrams showing different configurations of the **transmission . . . system** of the present invention.

('992 Patent, Col. 3:50-53.)

> * * *
>
> FIGS. 2a and 2b illustrate detailed block diagrams of preferred implementations of the **transmission system** 100 of the present invention.

('992 Patent, Col. 5:59-61.) It is clear from the specification that the patentee intended "transmission system" to mean a particular assembly of elements depicted in the drawings and described in the specification. These elements are configured in such a fashion to fulfill the purposes of storing, retrieving and identification encoding, formatting, ordering, compressing, storing in a compressed data library, and transmitting information.

Further, in describing the components of the transmission system, the specification states which components are "coupled to" one another. The Court has previously defined "coupled to" to mean "directly connect to or attached to." (July 12 Order at 24.) The specification that a particular component be coupled to another is significant because it means that in order for information to proceed from one component to another, it must follow the same sequence. It also means that each interconnected component is essential because information can only be transferred to an interconnected component.

As used in Claim 19 of the '992 Patent, the Court construes the phrase **"transmission system"** to mean:

> **An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function.**

4. "receiving system"

The parties dispute the proper construction of the phrase "receiving system" as that phrase is used in Claim 19 of the '992 Patent. One aspect of the dispute is the patentee's use in the specification of the phrases "receiving system" and "reception system." The dispute is whether the two phrases are used interchangeably in the patent specification and should, therefore, be given the same definition.

The specification uses the phrases "receiving system" and "reception system" interchangeably.[2] For example, Figures 1a - 1g are block diagrams which contain graphic figures labeled "**200**," entitled "RECEPTION SYSTEM." With respect to Figures 1a - 1g, the written description describes them as illustrations of an embodiment of "receiving systems:"

> With respect to the transmission and **receiving systems** set forth in Figures 1a-1g. . .
>
> * * *
>
> In any of the transmission and **receiving systems** illustrated in FIGS. 1a - 1g, the requested material may be copy protected.

('992 Patent, Col. 4:64-65; Col. 5:34-35.)

With specific reference to Figure 1d, the specification uses the phrases "receiving systems" and "reception systems" interchangeably:

> FIG. 1d shows a high level block diagram of the transmission and **receiving system** of the present invention including a transmission system 100 distributing to a plurality of users via a **reception system 200** configured as a cable television system.

('992 Patent, Col. 4:14-18.)

At one point in the specification, graphic block 200 is called a "receiving system." At another place it is called a "reception system:"

> ... for communication with the **receiving system 200** . . .
>
> * * *

---

[2] The Court's attention is drawn to Claim 2 of the '275 Patent which also shares the same specification as the '992 Patent. Claim 2 of the '275 Patent does not use the terms interchangeably. Instead, Claim 2 refers to "receiving system" and "reception system" as being two separate but "associated" systems:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to **receiving systems** at remote locations, the method comprising the steps of:
>
> * * *
>
> sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to a **reception system associated with a receiving system** at one of the remote locations selected by the user; . . .

Except for their use in Claim 2 of the '275 Patent, throughout the specification the patentee used the two phrases interchangeably. The Court will defer consideration of the effect of its construction on Claim 2 of the '275 Patent until that Claim is formally brought into consideration.

> The received information is preferably buffered (step 418) by a storage means analogous to element 203 shown in FIG. 3. The information is preferably buffered so that it may be stored by the user for possible future viewings. The requested information is then payed back to the **reception system 200** of the user at the time requested by the user (step 419).

('992 Patent, Col. 6:31-32; Col. 19:30-36.) In light of the specification, the Court finds that the phrases "receiving system" and "reception system" should be given common definitions.

A second aspect of the dispute with respect to the phrase "receiving system" is the definition of the phrase itself. In the July 12 Order, the Court construed the phrase "reception system," used in Claim 1 of the '702 Patent, to mean "an assembly of elements, hardware and software, capable of functioning together to receive items of information." (July 12 Order at 28-29.) The '702 Patent shares the same specification as the '992 Patent. Upon reconsideration following the June and September hearings, the Court finds that the patentee intended "receiving system" to have a specialized meaning:

> Additionally, the present invention comprises a **receiving system** responsive to a user input identifying a choice of an item stored in a source material library to be played back to the subscriber at a location remote from the source material library, the item containing information to be sent from a transmitter to the receiving system, and wherein the receiving system comprises **transceiver means** for automatically receiving the requested information from the transmitter as compressed formatted data blocks; **receiver format conversion means**, coupled to the transceiver means, for converting the compressed formatted data blocks into a format suitable for storage and processing resulting in playback in real time; **storage means**, coupled to the receiver format conversion means, for holding the compressed formatted data; **decompressing means**, coupled to the receiver format conversion means, for decompressing the compressed formatted information; and **output data conversion means**, coupled to the decompressing means, for playing back the decompressed information in real time at a time specified by the user.

('992 Patent, Col. 2:61 - Col 3:14.)

Figure 6 is a block diagram illustrating an embodiment of a reception system which has the necessary components to perform the method disclosed in Claim 19. The specification also contains the phrase "receiving device." The specification provides that a "receiving device" is not part of a "receiving system:"

> The outputs from converters 211-214 are produced in real time. The real time output signals are output to a playback system such as a TV or audio amplifier. They may also be sent to an audio/video recorder of the user. By using the reception system 200 of the present invention, the user may utilize the stop, pause, and multiple viewing functions of the **receiving device**. Moreover, in a preferred embodiment of the present invention, the output

> format converters may be connected to a recorder which enables the user to record the requested item for future multiple playbacks.

('992 Patent, Col. 18:34-45.) The Court finds that the "receiving device" in the above excerpt is not a "receiving system."

Some of the Defendants contend that the Court should construe the phrases "receiving system" to mean "a system which receives information, **either electronically or optically**, **directly** from a transmission system." Given the electronic nature of the invention, one skilled in audio and video transmission art could arguably read the Yurt's family of patents as limited to electronic transmission. However, the specification does not limit the system to electronic or optical transmission. The specification provides that transmission uses "any available communication channel." ('992 Patent, Col. 15:65-67.) Accordingly, the Court declines to add the requested "electronic or optical" limitation, preferring to leave it as a matter which does not require construction giving the nature of the invention.

The Court finds, however, that the use of the word "directly" in its construction would clarify that the invention is one which discloses transmission directly to receiving systems with no intermediary.

The Court construes the phrase **"receiving systems"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, the phrase "receiving systems" means "an apparatus which directly receives information from the transmission system. The apparatus comprises the following interconnected components: transceiver means, receiver format conversion means, storage means, decompressing means and output data conversion means, as illustrated in Figure 6. The corresponding structure for each means is the structure identified in the specification for performing the recited function. A "reception system" is the same apparatus as a "receiving system." A "receiving device" is not part of a receiving system.**

5. "remote locations"

The Court has been asked to reconsider its construction of the phrase "remote locations." It is a phrase which appears in multiple Claims of the '992 Patent. In the July 12 Order, the Court found as follows:

> The parties request construction of the term "remote locations" that appears in claims 1, 19, 22, 25, 41, 47 and 54 of the '992 Patent.

* * *

> Therefore, the Court finds "remote locations" to have its ordinary meaning "positions or sites distant in space from some identified place or places." In claims 1 and 41 of the '992 Patent, the term "remote locations" means "positions or sites distant in space from the transmission system."

In light of the Court's determination that the Preamble of Claim 19 is limiting, the Court reexamines its construction of the phrase "remote locations," which is one of the limiting terms.

The Court construes **"remote locations"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, the phrase "remote locations" means "positions or sites distant in space from the transmission system."**[3]

6. "user"

Claim 19 claims a method for a transmission system and a receiving system to distribute information in response to requests from a "user." The parties dispute the construction of the word "user."

The specification contains numerous references to the "user" and to a related word "subscriber:"

The Abstract of the '992 Patent provides:

> A system of distributing video and/or audio information employs digital signal processing to achieve high rates of data compression. The compressed and encoded audio and/or video information is sent over standard telephone, cable or satellite broadcast channels to a receiver specified by a **subscriber** of the service, ...

The Summary of the Invention provides:

> Additionally, the present invention comprises a receiving system responsive to **a user** input identifying a choice of an item stored in a source material library to be played back to **the subscriber** ...

('992 Patent, Col. 2:62-65.)

The Description of Preferred Embodiments provides:

> The **user** then enters a customer ID code by which the system accesses the **user's** account, and indicates to the system that the **user is a subscriber** of the system (step 3030). In

---

[3] This construction also applies to the phrase as it appears in Claim 41 of the '992 Patent and Claims 2 and 5 of the '275 patent.

> response to the **user** entering his ID code in step 3030 the system confirms whether the **user** is in good standing (step 3040). If the **user** is in good standing, the system queues the **user** to input his request (step 3050).
>
> The **user** request may preferably be made from a catalog sent to each of the **subscribers** of the system. The **user** will preferably identify his choice and enter the corresponding identification code of the item (step 3060). The system then preferably confirms the selection that the **user** has made and informs the **user** of the price of the selection (step 3070).

('992 Patent, Col. 14:14-28.) From the specification, one of skill in the art would understand that the method described in Claim 19, is one in which, a person, called a "user" requests information from the system. Some embodiments disclose a process by which only authorized users, i.e., "subscribers" are able to receive the information.

The specification of the '992 Patent also uses the word "operator" in describing the transmission and reception systems and methods. However, the word "operator" is used in the specification to signify someone who acts as part of the transmission system and is not used by the patentee to describe a "user." Two types of operators are described in the invention, both of which can act as part of the "transmission system."

The first operator function is the "system operator's function" and is described as:

> The unique address code is an address assigned to the item by the system operator during storage encoding,
>
> * * *
>
> The storage encoding process may be run by the system operator.

('992 Patent, Col. 10:58-59; Col. 11:13-14.)

The second operator function is that of a "telephone operator," for the purpose of taking requests from a user and manually entering such requests into the transmission system:

> Access by the users via **operator** assisted service includes **telephone operators** who answer calls from the users. The **operators** can sign up new customers, take orders, and help with any billing problems. The operators will preferably have computer terminals which give them access to account information and available program information. Operators can also assist a user who does not know a title by looking up information stored in files which may contain the program notes, as described above. Once the chosen program is identified, the operator informs the user of the price. After the user confirms the order, the user indicates the desired delivery time and destination. The operator then enters the user request into the system. The request is placed in the transmission queue.

('992 Patent, Col. 14:49-63.)

The Court finds that the construction of the word "user" should make clear that a "user" is not an "operator" as those terms are used in the specification.

The Court construes "**user**" as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, the word "user" means "a person who requests information from items in the transmission system." Any person acting as part of the transmission system, such as an operator, is not a user or a subscriber.**

7. "items. . .containing information"

The parties dispute the proper construction of the phrase "items. . .containing information" as that phrase is used in Claim 19 of the '992 Patent.

In addition to the phrase "items containing information," the specification of the '992 Patent uses the following related phrases: "items," "information from items," "items in the source material library," "information in the items," "items having information," and "items of information."

In the July 12 Order, the Court construed the phrase "items containing information" as follows:

> The Court construes the term "items containing information" to mean **"items containing information in analog or digital format."** The limitation requiring the information be stored in **analog or digital** format is necessary as the conversion means element 113 only converts analog and digital inputs into a "formatted data" output.[4]

(July 12 Order at 11, citing '992 Patent, figure 2a.)

The current dispute is whether the word "items" as used in the '992 Patent refers to physical items. The specification refers to "items" as follows:

> The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects. These materials are converted to or recorded on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in a compressed data library 118.

---

[4] The Court inserted this footnote following the definition: "Neither the claims nor the specification of the '992 patent disclose any structure for converting information in the 'items' to analog or digital form as required by the 'conversation means,' before the items are stored in the library means. The claims and the specification disclose structure (figure 2a (113)), which converts only analog or digital information. Before the items are stored, the information in the 'items' stored in the library means must out of necessity already be in analog or digital format." (July 12 Order at 11, n. 6.)

('992 Patent, Col. 6:10-19.) The Court finds that a proper reading of the specification renders that the word "items" means physical objects and not the "information" which might be contained in the physical objects.[5] For example, a computer file, would be information. The media used to store the computer file, such as a computer disk or a computer tape, in the source material library would be a physical item containing the information.

The Court defines **"items. . .containing information"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which, responsive to requests from a user identifying "items" in a transmission system "containing information," information is sent from the transmission system to receiving systems at remote locations, the phrase "items containing information" means "physical items, such as video tapes, film, or computer disks, which contain audio information, video information or both."**

8. "information from items"

Claim 19 discloses a method for storing in the transmission system, "information from items" in a compressed data form. The parties dispute the proper construction of the phrase "information from items."

Given the Court's previous construction of "items containing information," the Court defines **"information from items"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, "information from items" refers to audio information, video information or both audio and video information, which is derived by the transmission system from a physical item such as a tape, a film, or a computer storage disk.**

9. "storing . . .information . . . in a compressed data form the information including an identification code and being placed into ordered data blocks."

Claim 19 provides in relevant parts:

A distribution method * * *comprising the steps of:

---

[5] A literal reading of Claim 19 is that the user requests "items containing information" (e.g., a video tapes) and that the items are "to be sent" from the transmission system to receiving systems. Thus, under this literal reading, the video tapes themselves would be sent. However, the specification makes it clear that the invention is not one in which the video tape is sent, but one in which movies are extracted from the video tapes, processed, and only the movies (information) are sent to the receiving systems.

> **storing**, in the transmission system, **information** from items **in a compressed data form**, the information including an identification code and being placed into ordered data blocks; . . .

The parties dispute the proper construction of this first "storing" step in the distribution method. Claim 19 contains a second storing step which is part of the receiving system. The Court will refer to this first "storing" step as the "storing information in a compressed data form" step. As part of its construction of this first step, the Court is asked to decide when, in the disclosed method, the unique identification code is assigned.

The specification of the '992 Patent discloses as an invention both apparatus and method claims. The apparatus disclosed is a system for distribution of audio and video information. Claim 19 is a "distribution method" drawn to the inherent functions of this distribution apparatus. In construing the words and phrases of Claim 19, the Court relies on a description of an embodiment of the method which is contained in Figure 7 and in the specification at column 18, line 53.[6] The distribution method in Figure 7 must be performed in the following sequence:

(a) retrieve information for selected items,

(b) assign a unique identification code (storage encoding)[7],

---

[6] Column 18, lines 50-52 provides: "Method 400 assumes that the items have already been stored in compressed data library 118." This provision contradicts the method illustrated in Figure 7 and described in Column 18: 53-19:36.

[7] The specification defines "storage encoding" and by its definition, it is clear that "storage encoding" is a step in the method different from "storing information in compressed data form." The specification provides:

> Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112. **Storage encoding**, performed by identification encoder 112, aside from giving the item a unique identification code, optionally involves logging details about the item, called program notes, and assigning the item a popularity code. **Storage encoding may be performed just prior to conversion** [conversion means 113] of the item for transmission to reception system 200, **at any time after starting the conversion process** [conversion means 113] , **or after storing the item in the compressed data library** 118.

('992 Patent, Col. 6:35-47.)

Thus, assigning a unique identification code and other optional encoding of details or notes, all of which are called "storage encoding," may be performed: (a) just before conversion of the data to a suitable format for transmission; (b) during conversion of the data to a suitable format for transmission; or (c) after the data has been stored in the compressed data library.

(c) converting and formatting,

(d) ordering into addressable data blocks,

(e) compressing,

(f) compressed data formatting and storing into compressed data library,

(g) transmitting the information in response to a user request,

(h) receive at remote location,

(I) buffer the data,

(j) playback at time requested.

In light of the specification, the Court finds that before the "storing information in a compressed data form" step is performed, the information must already have been assigned an identification code, converted, placed in ordered data blocks and compressed.

Other passages in the specification clarify that the "storing information in a compressed data form" step takes place after the unique identification code has been assigned:

> In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113.
>
> * * *
>
> In accordance with a preferred embodiment of the present invention, the transmission system 100 may further comprise **compressed data storing means**, coupled to the compression means, **for storing as a file the compressed sequenced data with the unique identification code received from the data compression means**. After compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a single file by the compressed data storage means 117. The file may contain the compressed audio and/or video data, time markers, and the program notes. **The file is addressable through the unique identification code assigned to the data by the identification encoder** 112.

('992 Patent, Col. 6:58-62; Col. 10:17-30.) There is no place in the specification which describes how the unique identification code could be stored after the information has been placed in the compressed data library. In all embodiments, storing in compressed data form is described as being done with the unique identification code already assigned. Accordingly, in construing the step under consideration, the Court will define it so that the unique identification code is assigned after the step of "retrieving information from the source material library" and before the step of "placing data in predetermined format."

The first step of the method disclosed in Claim 19 is storing information in the compressed data library which, according to the specification, is performed by the compressed data storing means. Based on the language of this storing step, the information must have been assigned an identification code, compressed and put into order data blocks before the storing step.

The specification of the '992 Patent provides that, if information in the transmission system has already undergone a process otherwise performed by the transmission system, it may be passed directly to the compressed data formatter:

> In some cases, such as in inter-library transfers, incoming materials may be in a previously compressed form so that there is no need to perform compression by precompression processor 115 and compressors 128 and 129. In such a case, retrieved items are passed directly from identification encoder 112 to the compressed data formatter 117.

('992 Patent, Col. 7: 44 - 49.) It is apparent that assigning an identification code, formatting and compressing are essential functions which must be performed on the information before transmitting the information to the reception system. Accordingly, the Court interprets the storing step as operating on information which has already been encoded, formatted and compressed prior to the start of the method. Indeed, unless the "storing" step is construed in this fashion, an argument could be made that Claim 19 omits steps in the sequence which are essential to the distribution method as taught in the specification.

The step uses the phrase: "**being placed into ordered data blocks**." To preserve the validity of the Cl aim, the Court construes this phrase as "**having been placed into ordered data blocks.**"

The Court construes **"storing . . . information from items in compressed data form"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, "storing . . . the information in a compressed data form, the information including an identification code and being placed into ordered data blocks" means: "storing the information, along with an identification code, in the compressed data library of the transmission system, when, previously to storing: (a) an identification code has already been assigned to the information; (b) the information has been placed into ordered data blocks, and (c) the information has been compressed."**

10. "at least a part [portion] of the stored information"

Claim 19 provides in pertinent parts:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to **receiving systems** at **remote locations**, the method comprising the steps of:
>
> > storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;
> >
> > sending a request, by the user to the transmission system, for **at least a part of the stored information** to be transmitted to one of the receiving systems at one of the remote location selected by the user;
> >
> > sending **at least a portion of the stored information** from the transmission system to the receiving system at the selected remote location.

The Court finds as follows:

The phrases "portion of the stored information" and "part of the stored information," as used in Claim 19 of the '992 are synonymous.[8]

The Court does not find it necessary to further construe these phrases.

11. "playing back the stored copy of the information using the receiving system"

Claim 19 provides in pertinent parts:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:
>
> > * * *
> >
> > sending a request, by the user to the transmission system, for at least a part of the stored information . . .
> >
> > sending at least a portion of the stored information from the transmission system to the receiving system at the selected remote location;
> >
> > receiving the sent information by the receiving system at the selected remote location;
> >
> > storing a complete copy of the received information in the receiving system at the selected remote location; and

---

[8] The same terms appear in Claims 2 and 5 of the '275 Patent. Unless otherwise ordered, the Court's construction of these phrases as they appear in Claim 19 of the '992 Patent applies to these phrases as they appear in the '275 Patent.

> **playing back the stored copy of the information using the receiving system** at the selected remote location at a time requested by the user.

This step in the method uses the phrase "playing back," which is commonly understood to mean to reproduce stored audio and video information in real time. In this step playing back is accomplished by "using the receiving system." The specification does not disclose any embodiments of the "receiving system" that includes speakers or video displays which would facilitate "playback." Instead, the specification discloses that the "receiving system" outputs to "receiving devices" of the user for "playback:"

> The separated audio and video information are respectively decompressed by audio decompressor 209 and video decompressor 208. The decompressed video data is then sent simultaneously to converter 206 including digital video output converter 211 and analog video output converter 213. The decompressed audio data is sent simultaneously to digital audio output converter 212 and analog audio output converter 214. The **outputs** from converters 211-214 are produced in real time. The real time **output signals** are output to a playback system such as a TV or audio amplifier.
>
> The real time output signals are output to a playback system such as a TV or audio amplifier. They may also be sent to an audio/video recorder of the user. By using the reception system 200 of the present invention, the user may utilize the stop, pause, and multiple viewing functions of the receiving device. Moreover, in a preferred embodiment of the present invention, the output format converters may be connected to a recorder which enables the user to record the requested item for future multiple playbacks.

('992 Patent, Col. 18:27-45.)

The specification discloses embodiments of the "receiving system" which have playback controls, though there are no disclosures of speaker or video displays:

> The reception system 200 has playback controls similar to the controls available on a standard audio/video recorder. These include: play, fast forward, rewind, stop, pause, and play slow.

('992 Patent, Col. 17:35-38.)

//

The specification discloses two configurations of a reception system, "direct connection"[9] and "non-direct connection." However, the specification discloses no structure which would allow a user to communicate directly with the reception system in a non-direct connection configuration. The Court interprets the embodiment of the reception system with playback controls as referring to a direct connection configuration. Accordingly, the "playback" step under consideration is defined to include both embodiments.

The Court construes the term **"playing back ... using the receiving system,"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, "playing back the stored copy of the information using the receiving system" means "using the receiving system to output the stored copy of the information in real time."**

12. "at a time requested by the user"

Claim 19 provides in pertinent parts:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:
>
> > * * *
> > sending a request, by the user to the transmission system, for at least a part of the stored information . . .
> >
> > sending at least a portion of the stored information from the transmission system to the receiving system at the selected remote location;
> >
> > receiving the sent information by the receiving system at the selected remote location;
> >
> > storing a complete copy of the received information in the receiving system at the selected remote location; and
> >
> > playing back the stored copy of the information using the receiving system at the selected remote location **at a time requested by the user**.

---

[9] In **direct connection configurations**, such as reception system 200 shown in Figures. 1e and 1f, the user preferably select the reception system 200 to which the requested material is sent, and optionally selects the time playback of the requested material as desired. Accordingly, the user may remotely access the transmission system 100 from a location different than the location of receptions system 200 where the material will be sent and/or played back. Thus, for example, a user may preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing." ('992 Patent, Col. 5:10-21.)

The Court finds that the "time" in the phrase "at a time requested by the user" refers to the time the user wants to receive the information at a device, such as a TV or VCR. This method gives the user the ability to designate a playback time. In this regard, the parties raise two issues: 1) whether designation of a playback time is optional or mandatory; 2) when, i.e., at what point is the playback time designated.

With respect to the first issue, to determine the optional or mandatory nature of the playback time, Court examines Figure 3, which is a flowchart of an embodiment of a distribution method practicing the claimed invention. Step 3090 of Figure 3 provides: "User may enter time and destination." The use of the word "may" suggests that the playback time is optional rather than mandatory. However, the specification does not contain the optional language of "may:"

> The user then indicates whether the confirmation performed in step 3070 is correct (step 3080). If the confirmation performed in step 3070 is correct, **the user so indicates and then inputs a desired delivery time and delivery location** (step 3090).

('992 Patent, Col. 14:29-33.) The specification does not disclose a means for the user to communicate with the transmission system after making the request for transmission of the information. This leads the Court to the second issue—at what point is the playback time designated.

First, a reasonable interpretation of the phrase "at a time requested by the user" is one in which "at the time" the user makes a request to the transmission system to transmit the information, the user designates a playback time which is at the time of the transmission or at a time later than the time of the transmission. While the transmission request and the playback time request must be made by the user to the transmission system at the same time, the actual playback time may be later than the transmission request time. This interpretation is supported by the specification. Figure 6 is a block diagram of an embodiment of the reception system. The specification of Figure 6 discusses playback time as follows:

> In the reception system 200 of the present invention, **the user may want to playback the requested item from the source material library 111 at a time later than when initially requested**. If that is the case, the compressed formatted data blocks from receiver format converter 202 are stored in storage 203. Storage 203 allows for temporary storage of the requested item until playback is requested.
>
> When playback is requested, the compressed formatted data blocks are sent ot [sic] data

> formatter 204. Data formatter 204 processes the compressed formatted data blocks and distinguishes audio information from video information.

('992 Patent, Col. 18:14-26.) It is apparent that the user would be required to specify a playback time as part of the initial request. However, the user could specify a playback time which is later in time than the time when the request for transmission itself is being made. After the material is transmitted, it would be stored automatically in "storage 203" in the reception system. When the specified delayed playback time arrives, the system would automatically output it in real time. Although a delay in output would occur, the time for output would have been specified at the time of the initial request. There is no means disclosed in the specification by which the user can communicate with the transmission system to modify the designated delayed output time.

Second, there is support in the specification for an embodiment in which the user initiates playback after the information has been received by the reception system. The specification discloses an embodiment in which the user is able to request a particular song, for example, directly from the information "buffered"[10] in the reception system:

> For example, a user may desire to listen to a particular song. They may preferably enter the song number either when requesting the item from the compressed data library 118 and only have that song sent to their receiving system 200 or they may preferably select that particular song from the items buffered in their receiving system 200.

('992 Patent, Col. 8:36-42.) In another provision, the specification discloses an embodiment in which the reception system has playback controls which would allow the user to communicate a playback request directly to the reception system:

> The reception system 200 has playback controls similar to the controls available on a standard audio/video recorder. These include: play, fast forward, rewind, stop, pause, and play slow.

('992 Patent, Col. 17:35-39.)

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[10] The Court interprets "buffered," in this context, to mean "temporarily stored." There is no mention in the specification of what kind of a buffering device a user would have in such a receiving system.

These embodiments in which the user is able to communicate a playback request directly from storage[11] in the reception system are described in the specification as direct connection configurations in which the reception system is located at the user's premises:

> In **direct connection configurations**, such as reception system 200 shown in FIGS. 1e and 1f, the user preferably select the reception system 200 to which the requested material is sent, and **optionally** selects the time playback of the requested material as desired. Accordingly, the user may remotely access the transmission system 100 from a location different than the location of receptions system 200 where the material will be sent and/or played back. Thus, for example, a user may preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing.
>
> In **non-direct connection** reception systems such as shown in reception system 200 of FIG. 1f, intermediate storage device 200c may preferably include, for example, sixteen hours of random access internal audio and video storage. A reception system with such storage is capable of storing several requested items for future playback. The user could then view and/or record a copy of the decompressed requested material in real time, or compressed in non-real time, at a time of their choosing. Accordingly, the user would not have to make a trip to the store to purchase or rent the requested material.

('992 Patent, Col. 5:10-33.) There is no detail for these embodiments. In any event, neither of these references to user controls at the reception system lead the Court to come to a different conclusion that the phrase "at the time requested by the user" should be construed to require that a playback time must be designated at the time of the initial transmission request.

The Court defines at **"a time requested by the user"** as follows:

> **In a distribution method as disclosed in Claim 19 of the '992 Patent, in which a transmission system sends information to receiving systems at remote locations in response to a user's request, in a nondirect connection configuration, the phrase "at a time requested by the user" means "at the output time specified by the user when the user makes the request to the transmission system to transmit information." At the time the user makes a request to the transmission system to transmit information, the user must designate an output time. At the time of the transmission request, a user may designate a delayed output time. If so, the information is transmitted to the receiving system where it is stored and at the pre-designated time, the information is automatically output by the receiving system.**

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[11] The specification states that there can be "storage" in the reception system in a direct connection configuration: "Since items are preferably stored on random access media. . . ." (See '992 Patent, Col. 17:38-39.)

B. The '992 Patent - Claim 20

Claim 20 of the '992 Patent provides:

> The distribution method as recited in claim 19, wherein the information in the items includes **analog and digital signals**, and wherein **the step of storing the information comprises** the steps, performed by the transmission system, of:
>
> converting the analog signals of the information to digital components;
>
> formatting the digital signals of the information;
>
> **ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks** and;
>
> compressing the ordered information.

1. The Preamble of Claim 20

As with Claim 19, the Court finds that the Preamble of Claim 20 of the '992 Patent is limiting because the terms in the Preamble are used as antecedents to the elements of the claim.

2. Arguable Ambiguity of Claim 20

The Court finds it helpful to first set forth what it has found as arguable ambiguity with certain aspects of Claim 20 of the '992 Patent.

The elements of a method claim are manipulative steps that are performed on an article or workpiece. In Claim 20, the article being worked on is the "information from items" as disclosed in Claim 19. As discussed above, Claim 19 imposes limitations on the "information," namely, that it has been compressed, assigned an identification code, and placed into ordered data blocks prior to the storing step. Claim 20 further limits the "information" to being in analog and digital signals.

The Preamble provides: "The distribution method as recited in claim 19, **wherein the step of storing** the information **comprises**. . . ." Thus, Claim 20 substitutes its "storing" steps (converting, formatting, ordering and compressing) for the "storing"steps of Claim 19. However, the steps of "storing" as disclosed in Claim 20 (converting, formatting, ordering and compressing) are attributes of the information which, of necessity, must be already present in the information when it is presented for "storing" in the performance of Claim 20. As set out above, through its limitations, Claim 19 discloses a storing step on a workpiece to which an identification code must have already been assigned and already have been placed into ordered data blocks and compressed.

The fact that the method claimed in Claim 20 requires the performance of steps which of necessity are already present in the information before the steps commence renders Claim 20 arguably indefinite.

Another aspect of Claim 20 that makes it arguably indefinite is that it never discloses the actual step of "storing in the compressed data library." The Court finds that "storing" is an essential step of Claim 20 which has been omitted. The Court invites the parties to address the cited apparent ambiguities of Claim 20 in appropriate motions.

Furthermore, the Federal Circuit has held that an independent claim should not be interpreted in a way that is inconsistent with a dependent claim. Wright Med. Tech., Inc. v. Osteonics Corp., 122 F.3d 1440, (Fed. Cir. 1997) (citing Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed. Cir.), cert. denied, 516 U.S. 987 (1995)). Accordingly, the Court also invites the parties to address any implications of the Court's analysis of Claim 20 on the validity of Claim 19.

Notwithstanding the cited arguable ambiguity, the Court proceeds to consider other terms in Claim 20.

3. "analog and digital signals"

The Court has received no evidence that one skilled in the relevant art at the time of the application was aware of an item containing information that would contain both analog and digital signals. However, presuming that such an item is conceivable and could be part of the transmission system, the phrase "analog and digital signals" has a common meaning which require no further construction.

A question is raised as to whether the transmission system, which performs these steps, is capable of performing simultaneous operations on items containing both analog **and** digital signals. The apparatus claims pertaining to the transmission system have separated these functions. Claim 1 claims a generic conversion step, and Claims 3 and 4, depending from Claim 1, separately claim to convert analog and digital signals respectively.

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4. "ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks"

Claim 20 describes a method for storing the analog and digital signals involving "converting," "formatting," "ordering," and "compressing." The parties dispute the proper construction of the "converting," "formatting" and "ordering" steps.

The specification describes the process of converting and formatting the information:

> When the information from identification encoder 112 is digital, the digital signal is input to the digital input receiver 124 where it is **converted** to a proper voltage. A **formatter** 125 sets the correct bit rates and encodes into least significant bit (lsb) first pulse code modulated (pcm) data. Formatter 125 includes **digital audio formatter 125a** and **digital video formatter 125b**. The digital audio information is input into a digital audio formatter 125a and the digital video information, if any, is input into digital video formatter 125b. **Formatter 125 outputs the data in a predetermined format**.
>
> When the retrieved information from identification encoder 112 is analog, the information is input to an **analog-to-digital converter** 123 to convert the analog data of the retrieved information into a series of digital data bytes. **Converter 123 preferably forms the digital data bytes into the same format as the output of formatter 125.**

('992 Patent, Col. 7:1-18.)

In the July 12 Order, the Court construed the phrase "ordering means for placing the formatted data into a sequence of addressable data blocks" as a means-plus-function element. In a means-plus-function claim, the claims specify the function and the specification details the structure. The Court identified the "time encoder" (FIG. 2a 114) and its equivalents as the corresponding structure.

Claim 20 is not a means-plus-function claim. Thus, importing limitations from the specification is not appropriate. In Claim 20, the phrase "ordering into ... a sequence of addressable data blocks" is a very broad limitation which could include time encoding, as well as other ways of generating addressable data blocks. The parties have requested that the Court construe the word "addressable" as it applies to the data blocks. The specification contains the following with respect to the phrases "address" and "addressability:"

> Stored items are preferably accessed in compressed data library 118 through a unique address code. The unique address code is a file address for uniquely identifying the compressed data items stored in the compressed data library section of a library system. This file address, combined with the frame number, and the library system address allow for complete addressability of all items stored in one or more compressed data libraries 118.

('992 Patent, Col. 10:46-57.) It is clear that there are multiple uses of the phrases "address" and "addressable." The ordering step in Claim 20 follows the conversion and formatting steps, and precedes the compression step. The claim element requires that the formatted and converted data be ordered into a sequence of addressable data blocks. The term "addressable" in the context of Claim 20 refers to the addressabilty of portions of the information within a file, and is not physical storage addresses.

The Court construes **"ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks"** as follows:

> **In a distribution method in which a transmission system stores the information, "ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks" means "in the transmission system placing the converted analog signals and the formatted digital signals into a sequence of data blocks, such that the ordering of the data blocks permits the retrieval of portions of information from items." "Addressable" does not refer to physical storage locations, but rather to positions relative to the beginning of a file containing information.**

C. The '992 Patent - Claim 21

Claim 21 of the '992 Patent provides:

The method of claim 19 wherein the step of storing the items includes the substep of

> storing the items in a plurality of compressed audio and video libraries in the transmission system.

1. The Order of the Steps of Claim 21

The parties dispute the order of the steps of Claim 21. Claim 19, in the first "storing" step, has only one step, namely that of "storing" information in the compressed data library 118, performed by the compressed data storing means 117. Claim 21 further limits Claim 19 to storing in more than one compressed data library. Claim 21 also necessitates that the first "storing" step in Claim 19 actually performs the step of storing information in the compressed library. If this were not the case, Claim 21 would be invalid. Independent claims are not to be construed to invalidate dependent claims.

The Court construes Claim 21 the '992 Patent as follows:

> **In a distribution method in which a transmission system is storing information in a compressed data form, the storing of the information can be in any order in several compressed data libraries.**

D. The '992 Patent - Claim 41

Claim 41 of the '992 Patent provides:

> A method of transmitting information to **remote locations**, the transmission method comprising the steps, performed by a **transmission system**, of:
>
> > **storing** items having information in a **source material library**;
> >
> > retrieving the information in the items from the source material library;
> >
> > assigning a unique identification code to the retrieved information;
> >
> > **placing the retrieved information into a predetermined format as formatted data;**
> >
> > **placing the formatted data into a sequence of addressable data blocks**;
> >
> > compressing the formatted and sequenced data blocks;
> >
> > storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
> >
> > sending at least a portion of the file **to one of the remote locations.**

1. The Preamble of Claim 41

For the reasons stated with respect to Claim 19, the Court finds that the Preamble of Claim 41 of the '992 Patent is limiting in that the method of transmitting information must be performed by a "transmission system," capable of performing the method.

2. The Order of the Steps of Claim 41

The parties agree that the steps of Claim 41 must be performed in the order enumerated in the claim. However, there is a dispute with respect to whether a prior step must be completed before a succeeding step may commence. (See Joint Chart of the Parties Proposed Definitions for Claim Terms From the '992 and '275 Patents at 9, ¶ 22.)

The language of Claim 41 makes each step antecedent to each succeeding step. As discussed in the order of the steps of Claim 19, a step, which is an antecedent to a succeeding step, must commence before the succeeding step commences, and the antecedent step must finish before the succeeding step can finish.

//

3. "transmission system"

The Court construes the phrase **"transmission system"** as used in Claim 41 as having the same meaning as given to the phrase as used in Claim 19.

4. "storing items having information in a source material library"

The parties dispute the proper construction of the phrase "storing items having information in a source material library."

As previously construed, the word **"items"** means physical items, such as video tapes, film, or computer disks, which contain audio information, video information or both.

The Court construes the phrase, **"items having information"** as used in Claim 41 to have the same meaning given to the phrase "items . . .containing information" as used in Claim 19.

The word **"storing"** is an active verb with a common meaning. The specification is silent as to any capabilities of the source material library to do any function other than to hold items having information. Since a step in a method must be a manipulative step or act, words such as "placing" or "putting" are appropriate synonyms for "storing" in the context of Claim 41.

In the July 12 Order, the Court defined the "source material library" as follows:

> The Court finds that the plain and ordinary meaning of the term "library" could mean either a collection of books or a place where books could be stored. The specification supports defining library to be a collection of original material, which contains analog or digital information, that the transmission system may convert, compress, and transmit. In other words, **the specification defines the source material library as a collection of original sources of information**.

(July 12 Order at 25.) The Court finds no reason to abandon this construction.

Accordingly, the Court construes the phrase "**storing items having information in a source material library**" as follows:

> **In a transmission method in which information from items having information is transmitted to remote locations and in which the transmission system performs the step of storing the items, the phrase "storing items having information in a source material library" means "placing physical items containing audio information or video information or both into a collection of original sources of information."**

//

5. "placing the formatted data into a sequence of addressable data blocks"

Consistent with its construction of Claim 20, the Court construes the phrase **"placing the formatted data into a sequence of addressable data blocks"** of Claim 41 of the '992 Patent as follows:

> **In a transmission method in which information is transmitted to remote locations and in which the transmission system performs the steps of placing the information into a predetermined format, the phrase "placing the formatted data into a sequence of addressable data blocks" means placing the formatted information into a sequence of data blocks, such that the ordering of the data blocks permits the retrieval of portions of information from items." "Addressable" does not refer to physical storage locations, but rather to positions relative to the beginning of a file containing information.**

6. "one of the remote locations"

The parties dispute whether the phrase "one of the remote locations" means "one or more" remote locations. The phrase has a plain and ordinary meaning. There is nothing in the specification or prosecution history which would support a specialized meaning.

The Court construes the phrase "**one of the remote locations**" as follows:

> **In a transmission method for transmitting information to remote locations comprising the steps performed by a transmission system of storing the information as a file and sending at least a portion of the file to one of the remote locations, the phrase, "one of the remote locations" means "a single remote location."**

E. The '992 Patent - Claim 42

Claim 42 of the '992 Patent provides:

> A transmission method as recited in claim 41, wherein the step of placing **further includes** the steps of:
>
> > A/D converting analog signals of the retrieved information into a series of digital data bytes; and
> >
> > **converting the series of digital data bytes into formatted data with a predetermined format.**

1. The Order of the Steps of Claim 42

It is undisputed that the steps of the elements of Claim 42 must be performed in the order that they appear in the claim. It is also undisputed that Claim 42 further limits the step of "placing ... as formatted data" of Claim 41. Claim 42 expressly states that it is adding further steps to Claim 41. There is a dispute with respect to whether the steps of Claim 42 are performed either before, after, or simultaneously with the relevant steps of Claim 41. Specifically, with respect to the "placing" step, Claim 41 provides:

> A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:
>
> * * *
>
> **placing the retrieved information into a predetermined format as formatted data;**

The Court finds that, if as required by Claim 42, the additional step "converting the series of digital data bytes **into formatted data with a predetermined format**" is added to the step of "placing **the retrieved information** into a **predetermined format as formatted data**" as required by Claim 41, then Claim 42 duplicates the "placing" step of Claim 41. This renders Claim 42 arguably indefinite as requiring extraneous and duplicative steps. The Court invites the parties to address the arguable indefiniteness of Claim 42 in appropriate motions.

F. The '992 Patent - Claim 43

Claim 43 of the '992 Patent provides:

> A transmission method as recited in claim 41, wherein the step of placing **further includes** the steps of:
>
> converting digital signals of the retrieved information into predetermined voltage levels; and
>
> **converting the predetermined voltage levels into formatted data with a predetermined format.**

Claim 43 is a dependent claim from Claim 41 and adds as a limitation that the step of "placing the retrieve information into a predetermined format as formatted data" operates on digital information. The Court's finding with respect to the sequence of the steps and of arguable indefiniteness of Claim 42 applies with equal force to Claim 43. The Court invites the parties to address the arguable indefiniteness of Claim 43 in appropriate motions.

G. The '992 Patent - Claim 45

Claim 45 of the '992 Patent provides:

> A transmission method as recited in claim 41, wherein the storing step further comprises the step of:
>
> **separately storing a plurality of files**, each including compressed, sequenced data blocks.

1. "separately storing a plurality of files"

Claim 45 is a method claim which depends from the method disclosed in Claim 41 and provides for separately storing a plurality of files. The specification does not describe storage in multiple files. The only description is storing a single file with "compressed, sequenced data blocks:"

> After compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a **single file** by the compressed data storage means 117.
>
> * * *
>
> After the data is processed into a file by the compressed data storage means 117, it is preferably stored in a compressed data library 118.

('992 Patent, Col. 10:23-26; Col. 10:36-39.) In light of the fact that there is no description of storage in multiple files, the Court declines to construe the phrase "separately storing a plurality of files" as arguably indefinite.[12]

H. The '992 Patent - Claim 46

Claim 46 of the '992 Patent provides:

> A transmission method as recited in claim 45, further comprising the steps, performed by the transmission system, of:
>
> generating a listing of available items;
>
> **receiving transmission requests to transmit available items**; and
>
> retrieving stored formatted data blocks corresponding to requests from users.

The Court requires further briefing on the sequence of Claim 46, particularly with respect to when the element generating the "list of available items" takes place. In addition, the Court requires additional briefing with respect to the following specification:

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[12] Claim 45 seems to be a method claim derived from apparatus Claim 6, which provides:

> A transmission system as recited in claim 2, wherein the compressed data storing means further comprises:
>
> compressed data library means for **separately storing a plurality of files**, each including at least one compressed, sequenced data block.

Claim 6 claims that the compressed data library means 118 is capable of storing (holding) more than one file. In other words, "separately storing a plurality of files" is an attribute of the compressed data storing means 118. The attribute of being capable of storing a plurality of files does not lend itself to conversion to a manipulative step.

> The library access interface 121 in the reception system 200 preferably includes a title window where a list of available titles are alphabetically listed. This window has two modes: local listing of material contained within the library system control computer 1123, and library listing for all available titles which may be received from the available, remotely accessible libraries. The titles listed in this window are sent from the database on the library system control computer 1123 or the remote order processing and item database 300.

('992 Patent, Col. 17:44-53.) The Court questions whether this is an error and should read in transmission system as shown in Figure 2b.

II. THE '275 PATENT

A. __The '275 Patent - Claim 2__

Claim 2 of the '275 patent provides:

> A distribution method responsive to requests from a user identifying items in a **transmission system***[13] containing information to be sent from the transmission system to **receiving systems*** at **remote locations***[14], the method comprising the steps of:
>
> **storing, in the transmission system, information from items in a compressed data form***, the **information including an identification code and being placed into ordered data blocks***;
>
> sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to **a reception system associated with a receiving system** at one of the remote locations selected by the user;
>
> sending at least a portion of the stored information from the transmission system to the reception system;
>
> receiving the sent information by the reception system;
>
> storing a complete copy of the received information in the reception system; and
>
> **playing back** the stored copy of the information **from the reception system to the receiving system** at the **selected remote location** at **a time requested by the user**.

1. The Preamble of Claim 2

For the reasons stated with respect to Claim 19 of the '992 Patent, the Court finds that the Preamble of Claim 2 of the '275 patent is limiting in that the distribution method must be performed by a "transmission system" which sends information to "receiving systems at remote locations" in response to requests from a "user."

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[13] Each item identified with an asterisk (*) is given the same meaning as the terms or phrases construed in the '992 Patent.

[14] The Court considers the phrase "remote locations," which is used in the Preamble, to be a statement of purpose. This phrase does not limit the elements of the claim to having to send information to multiple receiving systems. The language of the elements of the claim, which limits transmission to "one" location, is controlling.

2. "reception system associated with a receiving system at one of the remote locations selected by the user"

Claim 2 of the '275 Patent requires the following step:

> sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to a **reception system associated with a receiving system at one of the remote locations selected by the user**;

The parties dispute the proper construction of the phrase "reception system associated with a receiving system at one of the remote locations selected by the user."

In this step, the user makes a request to the transmission system to transmit information to a single reception system, which is selected by the user. The selected reception system is one which is "associated with" a single receiving system. Therefore, in order to perform this step the system must contain a "reception system" "associated" with a "receiving system at the remote location." As discussed in Section **A4** above, the written description uses the phrases "receiving system" and "reception system" synonymously. Accordingly, the Court finds that the method requires a configuration in which a "reception system" is associated with another "reception system." Except for the language of the claim itself, there is no support in the written description for defining a configuration for one reception system communicating to another reception system. This lack of support arguably could render the written description, based on the original application, inadequate to support the later filed Claim 2 of the '275 Patent. See 35 U.S.C. §§112, 119, 120.

The specification does disclose embodiments in which a "reception system" outputs to a "receiving device."[15] If the Court were to construe "receiving system" to mean a "receiving device"

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[15] The separated audio and video information are respectively decompressed by audio decompressor 209 and video decompressor 208. The decompressed video data is then sent simultaneously to converter 206 including digital video output converter 211 and analog video output converter 213. The decompressed audio data is sent simultaneously to digital audio output converter 212 and analog audio output converter 214. The outputs from converters 211-214 are produced in real time. The real time output signals are output to a **playback system such as a TV or audio amplifier**.

The real time output signals are output to a playback system such as a TV or audio amplifier. They may also be sent to an audio/video recorder of the user. **By using the reception system 200 of the present invention, the user may utilize the stop, pause, and multiple viewing functions of** the potential indefiniteness discussed above would be avoided. However, such construction would give an inconsistent definition to the phrase "receiving system," in patents which are based on the same specification. Accordingly, the Court declines to construe the term "reception system associated with a receiving system at one of the remote locations selected by the user," pending further proceedings with respect to whether Claim 2 of the '275 Patent complies with the written description requirement of 35 U.S.C. § 112.

3. "playing back" the stored copy of the information from the reception system to the receiving system"

The last step of the distribution method disclosed in Claim 2 of the '275 Patent is:

> **playing back** the stored copy of the information **from the reception system to the receiving system** at the selected remote location at a time requested by the user.

This step requires the reception system selected by the user to "playback" the received information to the receiving system. "Playback" has a plain and ordinary meaning. Playing back from the reception system to the receiving system is a form of communication between the systems. As discussed in Section **A2** of this patent, there is no support in the written description for one reception system to communicate information to another reception system.

In addition, Title 37 of C.F.R. Section 1.83(a) requires:

> (a) The drawing in a nonprovisional application **must show** every feature of the invention specified in the claims.

37 C.F.R. § 1.83(a) (1996). Claim 2 of the '275 provides no drawings of a reception system communicating with the receiving system. Therefore, the Court declines to give a construction to the phrase "playing back the stored copy of the information from the reception system to the receiving system" pending further proceedings to determine whether Claim 2 of the '275 Patent complies with the written description requirement of 35 U.S.C. §112.

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the receiving device. Moreover, in a preferred embodiment of the present invention, the output format converters may be connected to a recorder which enables the user to record the requested item for future multiple playbacks. ('992 Patent, Col. 18:27-45.)

B. The '275 Patent - Claim 5

Claim 5 of the '275 Patent provides:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:
>
> > storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;
> >
> > sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to a reception system associated with a receiving system at one of the remote locations selected by the user;
> >
> > sending at least a portion of the stored information from the transmission system to the reception system over an **optical fiber communication path**;
> >
> > receiving the sent information by the reception system;
> >
> > storing a complete copy of the received information in the reception system; and
> >
> > playing back the stored copy of the information **sent over a cable communication path** from the reception system to the receiving system at the selected remote location at a time requested by the user.

Claim 5 of the '275 patent is identical to Claim 2, except Claim 5 requires using an "optical fiber communication path" to send information from the transmission system to the reception system and requires using a "cable communication path" to playback the information from the reception system to the receiving system. The requirement of Claim 5, that the reception system communicate with a receiving system, raises the same written description issue addressed above. The Court will defer consider of this claim pending further proceedings with respect to both claims.

V. CONCLUSION

The Court has construed the words and phrases of the '992 and '275 Patents submitted for construction. Other claims submitted for construction will be the subject of a subsequent Order. The Court invites any party desiring to file motions with respect to this Third Claim Construction Order to do so in accordance with the Civil Local Rules of the Court.

Dated: December 14, 2006

James Ware

JAMES WARE
United States District Judge

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Dated: December 14, 2006

Richard W. Wieking, Clerk
By: /s/ JW Chambers
Elizabeth Garcia
Courtroom Deputy

EXHIBIT G

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

Acacia Media Technologies Corp.,

Plaintiff,

vs.

New Destiny Internet Group, et al.,

Defendants.

____

And All Related and/or Consolidated Actions.

______________________________________/

NO. C 05-01114

FOURTH CLAIM CONSTRUCTION ORDER

I. BACKGROUND

This is the Fourth Claim Construction Order in this Multi-District Litigation case in which Plaintiff, Acacia Media Technologies Corporation, asserts infringement involving the Yurt's Family of Patents entitled, "Audio and Video Transmission and Receiving System ('992, '275, '863, '720, and '702).

On July 12, 2004, the Court issued its First Claim Construction Order. (hereafter, the "July 12 Order," filed in SA CV 02-1040-JW (MLGx).)

On December 7, 2005, the Court issued its Second Claim Construction Order. (hereafter, the "December 7 Order," Docket Item No. 119.)

On December 14, 2006, the Court issued its Third Claim Construction Order. (hereafter, the "December 14 Order," Docket Item No. 216.)

This Order gives the Court's construction of disputed terms in the '863 and '720 Patents which were the subject of hearing in June and September, 2006.

II. WITHDRAWN CLAIMS

During the June and September hearings, the parties advised the Court that Acacia is withdrawing from assertion Claims 1-13 of the '863 Patent and Claims 1-3, 5, and 9-10 of the '720 Patent. The parties represented that a formal stipulation of withdrawal will be filed with the Court. In view of the tendered withdrawal of those Claims, the Court will not give further consideration to construing them, unless the Court finds it necessary to do so to construe a Claim which remains in contention.

III. STANDARDS

In addition to the authorities cited in this Order, the Court will apply the legal standards recited in its previous Claim Construction Orders.

IV. DISCUSSION

I. THE '863 PATENT

A. The '863 Patent - Claim 14

Claim 14 provides:[1]

A method of distributing audio/video information comprising:

transmitting compressed, digitized data representing a complete copy of at least one item of audio/video information at a non-real time rate from a **central processing location**;

receiving the transmitted compressed, digitized data representing a complete copy of the at least one item of audio/video information, at a **local distribution system** remote from the central processing location;

storing the received compressed digitized data representing the complete copy of the at least one item at the local distribution system;
in response to the stored compressed, digitized data, transmitting a representation of the at least one item at a real-time rate to at least one of a plurality of **subscriber receiving stations coupled to the local distribution system**; and

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[1] Unless otherwise indicated, all bold typeface is added by the Court to emphasize words and phrases under consideration.

> **decompressing the compressed, digitized data representing the at least one item of audio/video information after the transmission step wherein the decompressing step is performed in the local distribution system to produce the representation of the at least one item for transmission to the at least one subscriber station;**
>
> **wherein the transmitting step comprises**:
>
> **inputting an item having information into the transmission system**;
> **assigning a unique identification code to the item having information**;
> **formatting the item having information as a sequence of addressable data blocks**;
> compressing the formatted and sequenced data blocks;
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
> sending **at least a portion of the file** at the non-real time rate to the local distribution system.

1. The Sequence of Steps

Before construing the words and phrases in Claim 14, the Court considers whether the steps of the claimed method must be performed in a particular sequence and if so, the required sequence.

Unless steps of a method claim actually recite a sequence, claims are not ordinarily construed to require a sequence. Interactive Gift Express, Inc. v. Compuserve Inc., 256 F.3d 1323, 1342 (Fed. Cir. 2001). Interactive Gift recites a two-part test for determining if the steps of a method claim that do not otherwise recite an order, must nonetheless be performed in the order in which they are written. Id. at 1343. First, the court must look to the claim language to determine if, as a matter of logic or grammar, the steps must be performed in the order written. If not, the court next looks to the rest of the specification to determine whether it "directly or implicitly requires such a narrow construction." If not, the sequence in which the steps are written is not a requirement. Id. A sequence is required, for example, if a step references something logically indicating that a prior step had been performed. In such a case, the prior step must be performed first. Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc., 152 F.3d 1368, 1375-76 (Fed. Cir. 1998).

In the '863 Patent, **Steps (1)-(4)** of the method claimed in Claim 14 must be performed in the sequence in which they are written because each step references the previous step. This sequence may be summarized as follows:

Step (1) transmitting compressed digitized data to a local distribution system ["first transmitting step"] and then;

Step (2) receiving the transmitted compressed digitized data at the local distribution system ["receiving step"] and then;

Step (3) storing the received compressed digitized data at the local distribution station ["storing step"] and then;

Step (4) in response to the stored compressed, digitized data, transmitting a representation of the data from the local distribution station to a subscriber receiving station ["second transmitting step"].

In concluding that **Steps (1)-(4)** must be performed in the sequence in which they appear in the claim, the issue becomes when, in the sequence, does **Step (5)**, the "decompressing step," take place.

First, **Step (5)** requires "decompressing" the data "in the local distribution system," "after the transmission step." In order to meet those limitations, of necessity, decompression must take place after **Step (1)** (the "first transmitting step") has been executed. This is because it is only after **Step (1)** has been executed that the data is in "the local distribution system."

Second, **Step (5)** must be performed before **Step (4)** (the "second transmitting step") because after **Step (4)** the data is no longer in the local distribution system. In **Step (4)**, the data is transmitted to subscriber receiving stations and is no longer available for processing by the local distribution system.

Lastly, because **Step (5)** requires "decompression," it cannot be performed before **Step (2)** which requires receiving "compressed" data. Similarly, the decompression step cannot be performed before **Step (3)** because it requires storing "compressed" data. The decompression step cannot be performed before **Step (4)** because it is initiated in response to the stored "compressed" data. More importantly, as discussed above, the decompression step cannot be performed after **Step (4)** because in the execution of **Step (4)**, the data is transmitted out of the local distribution system and is no longer available in the local distribution system for decompressing.

The Court finds that the ambiguity as to when in the sequence the "decompressing" step is to be performed renders Claim 14 arguably indefinite.[2]

The Court invites the parties to address the issue of this arguable indefiniteness in motions for an evidentiary hearing or for summary adjudication. Notwithstanding the conclusion that Claim 14 is arguably indefinite, the Court considers other disputed words and phrases in Claim 14.

2. "central processing location"

Claim 14 claims the following step:

> transmitting compressed, digitized data representing a complete copy of at least one item of audio/video information at a non-real time rate from a **central processing location**

The parties dispute the proper construction of the phrase "central processing location" as that phrase is used in Claim 14 of the '863 patent. The phrase "central processing location" is used in the claim but it is not used elsewhere in the specification.

Courts may give a definition to a phrase which is only used in a claim if: a) the individual words in the phrase have well-recognized meanings to those skilled in the relevant art; and b) the court is able to discern a definition which the court, with reasonable confidence, finds would be understood by one skilled in the art based on the language of the claim and the other intrinsic evidence. See Bancorp Services v. Hartford Life Insurance Co., 359 F.3d 1367, 1372 (Fed. Cir. 2004).

To determine what "central processing location" means to those skilled in the relevant art, the Court turns to a standard dictionary prepared by the Institute of Electrical and Electronics Engineers ("IEEE"). The IEEE defines "centralized computer network" as: 1) a computer network configuration in which a central node provides computing power, control or other services; and 2) A computer network in which a central node provides all network control functions and services to other nodes. IEEE 100: Authoritative Dictionary of IEEE Standard Terms, 154 (7th ed. 2000).

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[2] If the phrase had been, "before the transmission step," the Court would have conducted a different analysis because with that wording, the step arguably could be construed to refer to the second transmission step. However, the Federal Circuit has admonished against judicial rewriting of claims. See Rhine v. Casio, Inc., 183 F.3d 1342, 1354 (citing Becton Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 799 & n. 6 (Fed. Cir. 1990)).

Thus, it is reasonable to characterize that in the field of data communications, the phrase "central processing" is generally understood by skilled artisans as a computer network configuration in which a single system at the hub distributes data to multiple peripheral dependent systems belonging to the network. In contrast, a system in which "processing" is distributed over multiple locations, would be understood by skilled artisans as a "decentralized system." Id. The term "central" does not refer to any particular geographic location. It refers to a functional location.

The step of Claim 14 under consideration discloses "transmitting" from a central processing location. Claim 14, contains specific limitations governing this transmitting step. These limitations are introduced using the transitional phrase "wherein the transmitting step comprises." The transmitting step is then prescribed as, among other limitations, inputting an item having information into "the transmission system," followed by "sending" the information to the local distribution system." The Court finds that the phrase "**transmission system**" as used in Claim 14 is the "**transmission system**" which the Court previously defined in its December 14 Order. (December 14 Order at Section IA3.) Accordingly, the "central processing location" is a limitation which defines the functional location of the "transmission system."

The Court construes the phase **"central procession location"** as follows:

> **a single transmission system, as previously defined, from which compressed, digitized data, representing a complete copy of the at least one item of audio/video information, is transmitted at a non-real time rate to at least one of a multiple of local distribution systems.**

3. "data representing a complete copy of at least one item of . . .information"

Claim 14 provides:

> transmitting compressed, digitized **data representing a complete copy of at least one item** of audio/video **information** at a non-real time rate from a central processing location

The parties dispute the proper construction of the phrase "data representing a complete copy of at least one item of information" as that phrase is used in Claim 14 of the '863 patent. The Court has already defined the phrases, "items containing information" and "information from items" in its December 14 Order. (See December 14 Order at Section IA7-8.)

In the '863 Patent, the written description, at times, equates "items of information" with "items having information." However, in the context of Claim 14, the Court construes **"items of . . . information"** to mean "**information derived from items**." With respect to the remaining words of the phrase, the Court finds that skilled artisans, reading the patent claim and written description, would give those words their ordinary and customary meanings.

The Court construes the phrase **"data representing a complete copy of at least one item of information"** as follows:

> **a complete copy of information from items.**

4. "local distribution system"

Claim 14 claims the following steps:

> receiving the transmitted compressed, digitized data representing a complete copy of the at least one item of audio/video information, at a **local distribution system** remote from the central processing location

The parties dispute the proper construction of the phrase "local distribution system" as that phrase is used in Claim 14 of the '863 patent. The '863 Patent is the first patent in the Yurt Family of Patents to use the phrase "local distribution system."

Under the principles of claim construction, there is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. Tandon Corp. v. U.S. Intern. Trade Comm'n, 831 F.2d 1017, 1023 (Fed. Cir. 1987). In addition, "[T]he terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Tandon Corp. at 831 F.2d at 1023, citing 37 C.F.R. 1.75(d)(1).

The '863 Patent shares the same written description with the other Yurt Patents. The phrase "local distribution system" is not used in the written description or prosecution history. In Section IA2, above, the Court construed "central processing location" to be the location of the transmission system. Under the written description and drawings, the transmission system transmits only to "reception systems." Therefore, the Court construes "**local distribution system**" to have the same meaning as **"reception system**."

In Claim 14, the distribution system is limited to a "local" system. The Court construes this limitation to have its commonly understood meaning to skilled artisans in this field, namely, a geographic location in close proximity to the user or subscriber.[3]

The Court construes the phase "**local distribution system**" as follows:

> **a reception system, as previously defined, located geographically close to subscriber receiving stations which are coupled to the reception system.**

5. "in response to the stored compressed, digitized data"

Claim 14 provides:

> **in response to the stored compressed, digitized data**, transmitting a representation of the at least one item at a real-time rate to at least one of a plurality of subscriber receiving stations coupled to the local distribution system

The parties dispute the proper construction of the phrase transmitting "in response to the stored compressed, digitized data" as that phrase is used in Claim 14 of the '863 patent.

The word "responsive" has a plain and ordinary meaning, namely, "answering." See Webster's New Twentieth Century Dictionary, 1543 (2d ed. 1983). In the field communications field, a responsive action is one which replies to a transaction generated by a request. IEEE 100: The Authoritative Dictionary of IEEE Standards Terms, 976 (7th ed. 2000). Thus, the word "responsive" is commonly understood to describe both a "cause-effect" relationship between two events and a timing relationship between them.[4]

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[3] In the communications field, "local" is commonly understood as something in close proximity to a user's device. For example, "local access and transport area (LATA): (1) In the United States, a local geographic area in which a local telephone company is allowed to offer communications services;" "local area network (LAN);. . . (3) A communication network to interconnect a variety of intelligent devices (e.g., personal computers, workstations, printers, file storage devices) that can transmit data over a limited area, typically within a facility." IEEE 100: The Authoritative Dictionary of IEEE Standards Terms, 633 (7th ed. 2000).

[4] In the "cause-effect" relationship, a second event is "responsive" to a first event if the first event causes the second event to happen. In the "timing" relationship, the second event is "responsive" if the second event happens after the first event. The Court finds that these two

The Court finds that one of skill in the relevant art reading the patent documents would give the phrase "in response to the stored compressed data" in its plain and ordinary meaning. Accordingly, the transmitting step is caused by the storing of the compressed, digitized data and is commenced after the storing of the compressed, digitized data.[5]

With respect to the timing concept included in the definition of "in response to," the parties dispute whether the responsive "transmitting" step may take place while the information is being stored in the local distribution system, or must the "transmitting" step wait to commence after the storing step has been completed. In the December 14 Order, the Court held that a step, which acts as an antecedent for a subsequent step, must commence before the succeeding step commences, and it must finish before the succeeding step can finish. However, the succeeding step can start while the antecedent step is in process. (See December 14 Order at Section IA2.) The Court gives this same interpretation to Claim 14 and finds that the responsive transmitting step can start before the antecedent storing step has been completed.

The Court construes the phrase transmitting **"in response to the stored compressed, digitized data**" as follows:

> **transmitting a representation of the at least one item which is initiated by the commencement of storing compressed, digitized data or by the completion of storing compressed, digitized data.**

6. "subscriber receiving station," "subscriber station"

Claim 14 provides:

> in response to the stored compressed, digitized data, transmitting a representation of the at least one item at a real-time rate to at least one of a plurality of **subscriber receiving stations coupled to the local distribution system**
>
> * * *

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concepts are not mutually exclusive.

[5] Although it is not explicitly stated as a step, because the information which is stored is the same information which is being transmitted (albeit at a real-time rate), a step of retrieving the information from the place where it is being stored is necessary before the information can be transmitted.

> decompressing the compressed, digitized data representing at least one item of audio/video information after the transmission step wherein the decompressing step is performed in the local distribution system to produce the representation of the at least one item for transmission to at least one **subscriber station**

The parties dispute the proper construction of the phrases "subscriber receiving station" and "subscriber station" as those phrases are used in Claim 14 of the '863 patent.

Except for its use in some of the claims of the '863 Patent, neither the phrase "subscriber receiving stations" nor the phrase "subscriber station" appear elsewhere in the specification. In Section IA4 above, the Court defined "local distribution system" to mean "a reception system located geographically close to the subscribers of the system." The Court examines the specification to see if it provides a basis for inferring a definition of the phrases under consideration.

Claim 14 claims a method in which information is transmitted from a central processing location [transmission system] to a local distribution system [reception system], and from there to a "subscriber receiving station." There is no support in the written description or in the drawings for a reception system to communicate with another reception system. Therefore, the Court declines to construe "subscriber receiving stations" as a "reception system."

However, there is support in the written description for a reception system which outputs to a "receiving device." ('863 Patent, Col. 17:43-61). To avoid a construction which is not supported by the written description, the Court construes "subscriber receiving station" as a receiving device. Further, because "subscriber receiving stations" and "subscriber station" are used synonymously, the definition applies to both phrases.

The Court construes the terms "**subscriber receiving station**" and **"subscriber station**" as follows:

> **a receiving device at a subscriber's location.**

7. "wherein the transmitting step comprises"

Claim 14 provides:

> **wherein the transmitting step comprises:**
> inputting an item having information into the transmission system;
> assigning a unique identification code to the item having information;

> formatting the item having information as a sequence of addressable data blocks;
> compressing the formatted and sequenced data blocks;
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
> sending at least a portion of the file at the non-real time rate to the local distribution system.

The transitional phrase, "wherein the transmitting step comprises" means that the recited elements are additional limitations on the "transmitting step." The Court refers to these as "additional limitations" so as to distinguish them from limitations which appear earlier in Claim 14. Most of the disputed words and phrases in these additional limitations are identical to phrases previously defined by the Court with respect to other claims. Accordingly, the Court adopts those definitions for the identical words and phrases. However, there are two aspects of these additional limitations on the transmitting step which require consideration.

8. "inputting an item having information into the transmission system"

The additional limitations of Claim 14 provide:

> wherein the transmitting step comprises:
> **inputting an item having information into the transmission system**;
> assigning a unique identification code to the item having information;
> formatting the item having information as a sequence of addressable data blocks;
> compressing the formatted and sequenced data blocks;
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
> sending **at least a portion of the file** at the non-real time rate to the local distribution system.

The first additional limitation of the transmitting step which the Court addresses include as an element, "inputting an item having information into the transmission system." Up to this point, none of the other distribution methods of the Yurt family of patents have disclosed the act of "inputting" in an element. The Court finds that one of ordinary skill in the art reading the patent documents would understand the phrase "inputting an item" in its plain ordinary sense, i.e., "putting the item in the transmission system."

Moreover, this particular additional limitation requires that the item which is being input be "an item having information." In the December 14 Order, the Court construed the phrase "items containing information" as used in Claim 19 of the '992 Patent to mean physical items such as videotapes or computer disks, which contain audio/video information. The Court construed the phrase "items having information" as used in Claim 41 of the '992 Patent to have the same meaning as "items containing information." (See December 14 Order at Sections IA7 and ID4.)

The Federal Circuit has held if an identical term appears in claims issuing from both a parent and a continuation application, a consistent meaning is preferred. Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc., 265 F.3d 1294, 1305 (Fed. Cir. 2001). Accordingly, with respect to these additional limitations, the Court gives the phrase "**inputting an item having information into the transmission system**" a meaning consistent with its previous construction as follows:

> **In a distribution method in which compressed, digitized data is transmitted to a local distribution system, the phrase "inputting an item having information into the transmission system" means "putting physical items containing audio information or video information or both into the transmission system."**

The second aspect of the additional limitations on the transmission step which the Court addresses is that they require "sending **at least a portion** of **the file** at the non-real time rate to the local distribution system." Elsewhere the method discloses "transmitting . . . at least **a complete copy** of at least **one item** of audio/video information." Both of these limitations apply to the same transmission step. The word "file" in one element refers to the same information as the word "item" in the other element. The fact that one element requires that "a complete copy" of the item be sent, while the other element discloses a method for sending "at least a portion" of the information creates a conflict between the elements. The Court finds that this conflict cannot be resolved by construing the latter element ("at least a portion") as controlling because the second step of the method requires "receiving . . . a complete copy." Accordingly, the ambiguity over what is transmitted renders Claim 14 arguably indefinite. The Court invites the parties to address the issue of this arguable indefiniteness in motions for an evidentiary hearing or for summary adjudication.

B. The '863 Patent - Claim 17

Claim 17 provides:

> A method of distributing audio/video information comprising:
>
> formatting items of audio/video information as compressed digitized data at a central processing location;
>
> transmitting compressed, digitized data representing a complete copy of at least one item of audio/video information from the central processing location;
>
> receiving the transmitted compressed, digitized data representing a complete copy of at least one item of audio/video information, at a local distribution system;
>
> storing the received compressed, digitized data representing the complete copy of at least one item at a local distribution system; and
>
> **using the stored compressed, digitized data to transmit** a representation of at least one item to at a plurality of subscriber receiving stations coupled to the local distribution system;
>
> wherein the formatting step comprises:
>
> inputting an item having information into the transmission system;
>
> assigning a unique identification code to the item having information;
> formatting the item having information as a sequence of addressable data blocks; and
>
> compressing the formatted and sequenced data blocks.

For Claim 17, the parties only dispute the proper construction of the phrase "using the stored compressed, digitized data to transmit a representation."

First, the Court applies its constructions of Claim 14 of the '863 Patent and Claim 19 of the '992 Patent to the corresponding terms of Claim 17. Second, even though the phrase "**using the stored compressed, digitized data to transmit a representation**" is grammatically awkward, the Court construes it as follows:

> **The phrase "using the stored compressed, digitized data to transmit a representation" means "transmitting a copy of the stored compressed digitized data.**

II. THE '720 PATENT

A. The '720 Patent - Claim 4

Claim 4 provides:

> A digital audio/video communication network comprising:
> a reception system **in data communication with** a plurality of **subscriber selectable receiving stations**, the reception system comprising,
> **means for receiving** compressed, digitized data representing at least one item of audio/video information at a non-real time rate,
> **means for storing** a complete copy of the received compressed, digitized data, and
> **means**, responsive to the stored compressed, digitized data, **for transmitting** a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations, wherein said means for receiving, said means for storing, and said means for transmitting are positioned at the same location, and wherein the at least one of the plurality of subscriber selectable stations is located at a premises geographically separated from the location of the reception system.

1. "in data communication with"

Claim 4 discloses a digital audio/video communication network comprising a reception system "in data communication" with a plurality of subscriber selectable receiving stations. The parties dispute the proper construction of the phrase "in data communication with."

In the July 12 Order, the Court construed the identical phrase as it is used in Claim 1 of the '702 Patent. The Court found that the phrase had a plain and ordinary meaning to those skilled in the relevant art and defined the phrase to mean "one or more devices connected such that data is being transferred between the devices in real time." (See July 12 Order at Section IVC1c.) Although the '702 Patent is no longer being asserted in this action, the Court adopts the same definition for the phrase as it is used in the '720 Patent.

The Court construes the phrase **"in data communication with"** as used in Claim 4 of the '720 Patent, as follows:

> **a reception system connected to subscriber selectable receiving stations such that data can be transferred between the devices in real time.**

2. "subscriber selectable receiver stations"

The parties dispute the proper construction of the phrase "subscriber selectable receiver stations." In Section IA6 above, the Court construed the phrases "subscriber receiving station" and "subscriber station" as they appeared in Claim 14 of the '863 Patent as "a receiving device at a subscriber's location." The Court finds that the apparatus claimed in Claim 4 of the '720 Patent is the same apparatus, except that as an additional limitation, it must be "selectable," a non-technical term which has a plain and ordinary meaning.

The Court construes the phrase **"subscriber selectable receiver stations"** as follows:

receiving device or devices which can be designated by the subscriber.

3. "means for receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate"

Claim 4 claims a reception system comprising three elements which are stated in mean-plus-function format. The parties dispute the proper construction of each of these three elements.

The first element of the reception system is "means for receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate." In construing the meaning of words and phrases used in a mean-plus-function element, the Court must first define the claimed function and any limitation which applies to that function. See Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed. Cir. 1999). Typically, the words and phrases following the phrase "means for" indicate the function which is performed by the element. Lockheed Martin Corp. v. Space Systems/Loral, Inc., 249 F. 3d 1314, 1324 (Fed. Cir. 2001). If there is a dispute over the meaning of the words and phrases which express the function of the element, their meaning must be decided by the court, using the well-established principles of claim construction. Id.

Applying these principles to the "receiving means" element, the Court finds that the claimed function is "receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate." The Court finds that no further construction is necessary to further define the words and phrases used to state the claimed function.

After the function of the element is defined, the Court must look to the written description to identify corresponding structure which is linked to performing that function. See Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed. Cir. 1999). The element must be construed "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1308 (Fed. Cir. 1998).

The Court examines the written description for corresponding structure and finds that it discloses a device which is linked to the function of receiving compressed, digitized audio/video information:

> The reception system 200 includes transceiver 201 which receives the audio and/or video information transmitted by transmitter 122 of the transmission system 100. The transceiver 201 automatically receives the information from the transmitter 122 as compressed formatted data blocks.

('720 Patent, Col. 17:16-21.)

The Court construes **"means for receiving"** as follows:

> **In the reception system disclosed in Claim 4 of the '720 Patent, "means for receiving" is transceiver 201 shown in Figure 6 and its equivalents.**

4. "means for storing a complete copy of the received compressed, digitized data"

The second element of the reception system disclosed in Claim 4 is "means for storing a complete copy of the received compressed, digitized data." As described above, the Court first defines the claimed function of the "storing means" and then examines the written description for corresponding structure.

The function of the "storing means" is "storing a completed copy of compressed, digitized data." With respect to corresponding structure, the written description discloses an embodiment of the reception system which includes a component called "storage 203." The device is described as performing the function of storing an "item" until playback is requested: "Storage 203 allows for temporary storage of the requested item until playback is requested." ('720 Patent, Col. 17:31-32.) In the described embodiment, the word "item" refers to compressed, digitized audio/video information received by the reception system. ('720 Patent, Col, 17:19-39). In addition, Figure 6 of the drawings, "storage 203" is drawn in the shape of a cylinder. The Court finds that this is a flow chart symbol which represents an electromechanical assembly of data storage media.

The Court construes **"means for storing"** as follows:

> **In the reception system disclosed in Claim 4 of the '720 Patent, "means for storing" means storing device 203 shown in Figure 6 and its equivalents.**

5. "means, responsive to the stored compressed, digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations"

The third element of the reception system disclosed in Claim 4 is "means, responsive to he stored compressed, digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations." This "transmitting means" element is expressed in means-plus-function format. Accordingly, the Court must decide the function of the "transmitting means" and identify any corresponding structure.

The function of the third element of the reception system is "transmitting a representation of an item of audio/video information at a real-time rate to one of at least a plurality of subscriber selectable receiving stations."

With respect to the "transmitting means" of Claim 4, the transmitting function must be "responsive to the stored compressed, digitized data." The parties dispute the proper construction of this phrase.

If a means-plus-function claim element contains a limitation on how the disclosed function is performed, the corresponding structure must be capable of performing the function with that additional limitation. Therefore, if there is a dispute over the words and phrases used in disclosing an additional limitation, the Court must construe the meaning of the words and phrases used in the additional limitation before examining the written description for corresponding structure.

In construing a limitation on the function of a means-plus-function element, the principles of claim construction apply. Courts must give the words of the element their ordinary and customary meaning as they would be understood by a person of ordinary skill in the relevant field. In construing the meaning of a limitation on the function of a means-plus-function claim, it is improper to narrow the scope of the function beyond the claim language. It is equally improper to broaden the scope of the claimed function by ignoring clear limitations in the claim language. Lockheed Martin Corp., 249 F.3d at 1324; See also Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 296 F.3d 1106, 1113 (Fed. Cir. 2002). Courts may not import into the definition of the limitation the features of an embodiment. JVW Enterprises, Inc. v. Interact Accessories, Inc., 424 F.3d 1324, 1331 (Fed. Cir. 2005). Any limitation must come from the claim itself, independent of any embodiment. Id.

The Court has previously defined the phrase "responsive to" in a method claim in a patent which shares the same specification as the '720 Patent. (See *supra* at Section IA5.) The Court construed the phrase to mean that a step to which a later step is "responsive" must be initiated by the commencement of the antecedent step. This same requirement applies to the use of the phrase "responsive to" in an apparatus claim. With respect to Claim 4, a structure which transmits "at least one item of audio/video information" "responsive to stored, digitized data" initiates transmission after recognizing that the storing of compressed digitized data has commenced or has been completed. In addition, since the transmission is of the information which is being stored, the structure must somehow retrieve the information to be transmitted. The Court now proceeds to examine the written description for corresponding structure.

The written description describes and Figure 6 of the drawings depicts an embodiment of the invention with a group of components which those of skill in the art would link to the functions of receiving audio/video data from storage device 203 and transmitting the data in "real time:"

> When playback is requested, the compressed formatted data blocks are sent [from storage 203][6] to data formatter 204. Data formatter 204 processes the compressed formatted data blocks and distinguishes audio information from video information.
>
> The separated audio and video information are respectively decompressed by audio decompressor 209 and video decompressor 208. The decompressed video data is then sent simultaneously to converter 206 including digital video output converter 211 and analog video output converter 213. The decompressed audio data is sent simultaneously to digital audio output

[6] The bracketed language is based on the previous paragraph in the written description that the "compressed formatted data blocks are stored in storage 203." ('720 Patent, Col. 17:29-32.

> converter 212 and analog audio output converter 214. The outputs from converters 211-214 are produced in real time.

('720 Patent, Col. 17:39-52.)

Accordingly, in defining corresponding structure for the "transmitting means," the Court's attention is drawn to components 204-206, 208-209 and 211-214. However, not only must the written description link a structure to the recited function, the description of the component must be adequate to allow one skilled in the art to understand what the component is and that it would be capable of performing the function. 35 U.S.C. 112 ¶ 2; Atmel v. Information Storage Devices, Inc., 198 F.3d 1374 (Fed. Cir. 1999).

With respect to the "transmitting means," several aspects of components described in the written description make them arguably inadequate to serve as corresponding structure. First, nothing in the written description discloses which of these component, if any, initiates transmission in response to the commencement of storing of compressed, digitized data. Second, although the written description discloses sending data from decompressors 208 and 209 to "converter 206," Figure 6 does not show a connection between these three components. Finally, although the written description contains names for components 204 ("Data Formatting"), 206 ("Output Format Conversion"), 208 ("Video Decompression"), 209 ("Audio Decompression"), and 211-214 ("Converters"), there is no description of whether these components are hardware, software or both. The Court invites the parties to address whether an evidentiary hearing on these issues would be beneficial. Pending the parties' response to this request, the Court defers defining the corresponding structure of the "transmitting means" of Claim 4.

B. The '720 Patent - Claim 6

Claim 6 provides:

> A digital audio/video communication network as recited in claim 4, further comprising a **processing station** for formatting items of audio/video information as compressed, digitized data and transmitting the compressed, digitized data representing at least one item of audio/video information at the non-real time rate to the means for receiving.

1. “processing station”

The parties dispute the proper construction of the phrase “process station” as used in Claim 6 of the ‘720 Patent.

Claim 6 is a dependent claim to Claim 4. The introductory language of Claim 6 uses the phrase “further comprising,” which means that the elements of Claim 6 are in addition to those recited in Claim 4. The phrase “process station” is used in the claim but it is not used in the written description. Therefore, the Court must determine whether a skilled artisan reading the patent document would understand the meaning of the phrase even if it is not used elsewhere in the specification. See Bancorp Services, 359 F.3d at 1372.

In Section IA2 above, using the principles of claim construction discussed in the Bancorp Services, the Court construed the phrase “central procession location” to be “a single transmission system, as previously defined, from which compressed, digitized data, representing a complete copy of at least one item of audio/video information, is transmitted at a non-real time rate to at least one of a multiple of local distribution systems.” The Court finds that the phrase “processing station” is synonymous to a “transmission system.”

The Court construes the phrase “**process station**” as follows:

the transmission system as previously defined by the Court.

C. The ‘720 Patent - Claim 7

Claim 7 provides:

A digital audio/video communication network as recited in claim 6, wherein the processing station comprises:

means for inputting items of audio/video information;

conversion means for placing each input item of audio/video information into a predetermined format as formatted data;

compression means for compressing the formatted data; and

transmitter means for sending compressed formatted data for the at least one item of audio/video information at the non-real time rate to the reception system.

Claim 7 depends from Claim 6. The elements of Claim 7 are limitations which apply to the "processing station" claimed in Claim 6.

1. "means for inputting items of audio/video information"

The first element of the "processing station" in Claim 7 is a "means for inputting items of audio/video information." As discussed above, since the claim is in a means-plus-function format, the Court must first identify the claimed function and then look to the written description to identify corresponding structure which is linked to performing that function. See Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed. Cir. 1999).

With respect to identifying a function, the phrase "inputting items of audio/video information" describes a commonly understood function, i.e., "inputting." To those skilled in the relevant art, the function of "inputting" means the act of "putting or taking something into a structure or process."

In addition to claiming "inputting" as a function, Claim 7 specifies an additional limitation on that function, namely, what in particular is being inputted. Claim 7 discloses inputting "items of audio/video information. There is a dispute over the meaning of the phrase "items of audio/video information."

Based on the nature of the inventions disclosed in the '720 Patent, there are two possible definitions of the phrase "items of audio/video information:" (a) the phrase could be referring to inputting physical items which contain audio/video information (e.g., audio tape), or (b) the phrase could be referring to inputting the audio/video information retrieved from the physical items. The Court considers each of these separately.

a. Defining inputting "items of audio/video information" as inputting physical items containing audio/video information.

In the December 14 Order, the Court construed a similarly worded phrase used in another patent in the Yurt Family, namely, "items containing information." The Court defined the phrase as physical items, such as videotapes or computer disks, which contain audio/video information. (See December 14 Order at Section IA7.) In this Order, *supra* Section IA7, the Court defines another similarly worded phrase, i.e., "item having information," as physical items containing audio/video information.

The language under consideration, "items of audio/video information" could mean physical items which contain audio/video information or it could be referring to audio/video information which has been retrieved from the physical items. It is necessary for the Court to decide between these competing definitions because the definition affects what structure may correspond to the inputting function.

The written description provides:

> Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of **items** prior to conversion and storage in a compressed data library means. The **items of information** may include **analog and digital audio and video information** as well as physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.
>
> As shown in FIG 2a, the source material library means included in transmission system 100 preferably includes a source material library 111. The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts musical instruments, and other physical objects. These materials are converted to or recorded on a media format compatible to the **digital and analog inputs** of the system prior to being compressed and stored in a compressed data library 118. The different media formats preferably include digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks and cartridges.

('720 Patent, Col. 5:59-67- 6:1-14.)

This part of the written description discloses a "source material library," which temporarily stores "items," also called "items of information."[7] The "items of information" are "audio and video" information which is either already in a "media format" which can be processed by the system (e.g., digital or analog audio and video tape) or which is in a media format which require conversion to a "compatible" media type which can be processed by the system. Thus, a person skilled in the art would understand "items of information" as used in the above embodiment to be physical items, namely physical media which contains audio/video information. If the Court assumes for purposes of its analysis that the "items of audio/video information" being input by the inputting means are the items being placed in the source material library, then the phrase should be defined as physical media containing audio/video information. Before examining the written description for corresponding structure of inputting physical media into the source material library, the Court examines another limitation of Claim 7.

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[7] The Court finds that the reference to "temporary storage of **items** prior to conversion" and the phrase "**items of information**" in the next sentence refer to the same thing.

The element of Claim 7 which follows the "inputting means" is called a "conversion means." The function of the conversion means is to place "each input item of audio/video information" into a predetermined format as formatted data. The requirement of Claim 7 that the "conversion means" act on "each input item" means that the inputting means is antecedent to the conversion means. The definition of corresponding structure must recognizes the relationship of the inputting structure to the conversion structure. In other words, if we assume that items of audio/video information are physical media being input into the source material library, the Court must identify a structure which is consistent with each of those same physical items being outputted to the conversion structure.

With respect to structural apparatus, although the written description discloses a "source material library" which stores physical items containing audio/video information, the written description is devoid of any discussion of an apparatus or process for "inputting" those items into the source material library. The written description contains neither a discussion of the source material library performing the function of inputting physical items nor is there any discussion of an apparatus linked to the source material library which inputs items into it. Every reference in the written description to the source material library states that it "includes" audio/video materials. There is never a discussion of a structure to place media into the source material library.

The absence of any discussion in the written description of a structure to input items into the source material library is consistent with the drawings. The drawings depict multiple structures for processing audio/video information. However, there is no drawing of a structure which inputs physical media into the source material library. Therefore, the Court declines to identify the source material library as corresponding structure to the inputting means. If the Court is not able to identify any other structure linked to the inputting function, Claim 7 would be arguably indefinite.

The inputting means element is not defective simply because the source material library cannot be linked to the claimed function. The claim is valid as long as there is any structure which is linked to and performs the claimed function. Cardiac Pacemakers, Inc., 296 F.3d at 1113. The Court proceeds to examine the written description for any other corresponding structure. As discussed above, in order to qualify as corresponding, the structure must be clearly linked to performing the function of inputting physical media and must also satisfy the requirement that it act on the physical media before the media is acted upon by the structure which performs the conversion function.

The written description contains the follow discussion of an embodiment which includes a "digital telecine device" which processes physical media before it is converted:

> If, for example, the retrieved information to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a **digital telecine device to the digital input receiver 124.** Format conversion is the preferably performed by digital video formatter 125b. Accompanying audio information is passed through an optical or magnetic digital playback device. This device is connected to digital audio formatter 125a.

('720 Patent, Col. 7:23-30.)

This passage from the written description does not link the digital telecine device to performing all of the functions of the inputting means. In order to qualify as corresponding structure, the written description must link the digital telecine device to "putting or taking something [physical media containing audio/video information] into a structure or process." The above passage of the written description states that the physical media is "passed through" the digital telecine device. There is no discussion that the telecine device performs the function of inputting the physical media into itself or any other device or process. The Court has not been able to identify any structure which is linked to performing the inputting function for physical media containing audio/video information. Before concluding that Claim 7 is arguably indefinite, the Court examines an alternative definition of the claimed function and if supported by the patent documents, looks for corresponding structure.

b. Defining inputting "items of audio/video information" as inputting audio/video information retrieved from physical media.

Up to this point, the Court has been analyzing the construction of "inputting means" under an assumption that "items of audio/video information" should be defined as physical items containing audio/video information. Recognizing that an alternative definition of "items" is possible, the Court now proceeds to consider that alternative definition.

As indicated above, the phrase "items of audio/video information" is broad enough that one skilled in the art could regard it as referring to audio/video information which has been retrieved from the physical media on which it had been stored in the source material library or elsewhere in the system if that definition is supported by the patent documents. A different definition of the function would affect the identification of corresponding structure.

In the December 14 Order, the Court construed the phrase "information from items" as audio/video information retrieved from the physical items. (See December 14 Order at Section IA8.) Therefore, the issue is whether "items of" information" should be defined as synonymous with "information from items." The Court examines the written description to see if this alternative definition of the function is support by it.

The phrase "items of information" appears in the same portion of the written description previously considered by the Court:

> Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of **items** prior to conversion and storage in a compressed data library means. The **items of information** may include **analog and digital audio and video information** as well as physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.
>
> As shown in FIG 2a, the source material library means included in transmission system 100 preferably includes a source material library 111. The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts musical instruments, and other physical objects. These

> materials are converted to[8] or recorded on a media format compatible to the **digital and analog inputs** of the system prior to being compressed and stored in a compressed data library 118. The different media formats preferably include digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks and cartridges.

(‘720 Patent, Col. 5:59-67- 6:1-14.)

Conceivably, the conjunctive phrase: “audio and video information **as well as** physical objects such as books and records” could be construed to mean that the system is handling audio and video information, which are not physical objects, as well as books and records, which are physical objects. This alternative interpretation would mean the inputting means would have to input audio/video information which has already been retrieved from the physical media. For sake of completeness, the Court will assume this alternative definition and examine the written description for corresponding structure.[9] As previously stated, a corresponding structure must be one which recognizes that the information must next undergo the conversion function. Thus it must operate on pre-converted information.

The written description attributes the function of inputting pre-converted audio/video information which has been retrieved from physical media to the identification encoder:

> Prior to being made accessible to a user of the transmission and receiving system of the present invention, the **item** must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112.

---

[8] Although the written description discusses “conversion” in terms of making books or pictures compatible for inputting to the system, the Court finds that this conversion does not deprive the material of being in a pre-conversion state. The function of the conversion means in the second element of Claim 7 is not converting the information in books or photographs into a system compatible form.

[9] This analysis is for sake of completeness only and is not being adopted by the Court. If the patentee had used the conjunctive phrase “audio and video information as well as other physical object such as books and records” this would lead to a conclusion that audio and video information meant physical media. The phrase “as well as physical objects” leaves open the possibility that the series contains two kinds of materials: audio/video information and physical objects. This latter construction would mean that audio/video information was not a physical object. However, adopting this latter construction is questionable because a full reading of the passage shows that the “items of information” are described as including “audio and video” information which is already in a “media format” which can be processed by the system. “Media” are physical items containing information. In addition, the examples given of compatible media, namely, digital or analog audio and video tape, are examples of physical media.

> * * *
>
> When **the information** from identification encoder 112 is **digital**, the digital signal is **input** to the digital input receiver 124, where it is converted to a proper voltage.
>
> * * *
>
> When **the retrieved information** from identification encoder 112 is **analog**, the information is **input** to an analog-to-digital converter 123 to convert the analog data of the retrieved information into a series of digital data bytes.

('720 Patent, Col. 6:26-30, 57-59; Col. 7:1-4.) Therefore, if the "items of audio/video information" limitation is found to be the information retrieved from physical media prior to being acted upon by the conversion means, the structure in the specification which corresponds to the inputting of that information is "identification encoder 112." The phrase "identification encoder" has been ruled indefinite by the Court. Therefore, this construction, if adopted by the Court, would lead to a finding that Claim 7 is invalid for lack of corresponding structure for the inputting means.

Acacia contends that "analog receiver" 127 and "digital input receiver" 124 are corresponding structure to the "inputting means" if the function is defined as inputting information derived from physical media. (See Docket Item No. 184 at 62.) The Court declines to adopt Acacia's contention because in the written description the patentee acting as lexicographer defines these structures as part of the "conversion means:"

> The transmission system 100 of the present invention also preferably includes **conversion means 113** for placing the items from source material library 111 into a predetermined format as formatted data. In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into predetermined format as formatted data by the converter 113. The items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form. **Converter 113 therefore includes analog input receiver 127 and digital input receiver 124.**

('720 Patent, Col. 6:44-54.)[10]

---

[10] Adopting Acacia's contention would require the Court to identify receivers 127 and 124 as corresponding structure to both the "inputting means" and the "conversion means." This could arguably render the "inputting means" superfluous because the "conversion means" would perform the inputting function. A single structural element which contains components which performs two separate functions can be corresponding structure for two separate claims, each reciting one of those functions. In re Kelly, 305 F.2d 909, 911 (C.C.P.A. 1962). However, the written description clearly define these receiver structures as part of the conversion means and not of the inputting means.

To qualify as corresponding, a structure must not only perform the claimed function, but the specification must clearly associate the structure with performance of the claimed function. Cardiac Pacemakers, Inc., 296 F.3d at 1113. There is nothing in the written description which clearly links these receivers to the inputting means. Accordingly, under this alternative definition of the inputting function, the Court still finds Claim 7 arguably invalid for lack of corresponding structure.

2. "conversion means," "compression means," and "transmitter means"

The Court declines to construe the remaining disputed words and phases of the '720 Patent, pending further proceedings with respect to the conclusions reached in this Order.

V. CONCLUSION

In this Order, the Court has construed some of the disputed words and phrases of the '863 and '720 Patents submitted for construction. The Court invites any party desiring to file motions for reconsideration or for an evidentiary hearing to present extrinsic evidence with respect to those definitions to do so in accordance with the Civil Local Rules of the Court. There were words and phrases submitted for construction which were not addressed in this and other Orders. To the extent a party believes that further claim constructions are necessary, the Court invites that party to submit a request to that effect. The Court will notify the parties of any deadlines for making further motions in a Case Management Order. Any party wishing to file a motion for summary adjudication based on the Court's constructions is invited to do so in accordance with the Civil Local Rules of the Court.

Dated: March 2, 2007

JAMES WARE
United States District Judge

THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:

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Dated: March 2, 2007 **Richard W. Wieking, Clerk**

By: /s/ JW Chambers
Elizabeth Garcia
Courtroom Deputy

EXHIBIT H

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

Acacia Media Technologies Corp.,

Plaintiff,

vs.

New Destiny Internet Group, et al.,

Defendants.

And All Related and/or Consolidated Actions.

/

NO. C 05-01114

ORDER RE: MOTIONS FOR RECONSIDERATION OF CLAIM CONSTRUCTION ORDER; FIFTH CLAIM CONSTRUCTION ORDER

The Court has issued a series of Orders construing the words and phrases of the patents-in-suit. This Order addresses motions for reconsideration of several phrases.

I. STANDARDS

During the process of this litigation, the Court has stated the legal standards upon which it relies for construction of patent claims. The Court recites them here for convenience of reference.

A. General Principles of Claim Construction

Claim construction is a matter of law, to be decided exclusively by the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996). When the meaning of a term used in a claim is in dispute, the Court invites the parties to submit their respective proposed definitions and a brief, outlining the basis for their proposals. In addition, the Court conducts a hearing to allow oral argument of the respective proposed definitions. After the hearing, the Court takes the matter under submission, and issues an Order construing the meaning of the term. The Court's construction becomes the legally operative meaning of the term that governs further proceedings in the case. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The Court recognizes that claim construction is a fluid process, wherein the Court may consider a number of extrinsic sources of evidence so long as they do not contradict the intrinsic evidence. However, the Court acknowledges that greater weight should always be given to the intrinsic evidence. Phillips v. AWH Corp., 415 F.3d 1303, 1324 (Fed. Cir. 2005).

B. Construction from the View Point of an Ordinarily Skilled Artisan

A patent's claims define the scope of the patent: the invention that the patentee may exclude others from practicing. Id. at 1312. The Court generally gives the patent's claims their ordinary and customary meaning. In construing the ordinary and customary meaning of a patent claim, the Court does so from the viewpoint of a person of ordinary skill in the art at the time of the invention, which is considered to be the effective filing date of the patent application. Thus, the Court seeks to construe the patent claim in accordance with what a person of ordinary skill in the art would have understood the claim to have meant at the time the patent application was filed. This inquiry forms an objective baseline from which the Court begins its claim construction. Id.

The Court proceeds from that baseline under the premise that a person of ordinary skill in the art would interpret claim language not only in the context of the particular claim in which the language appears, but also in the context of the entire patent specification, of which it is a part. Id. at 1313. Additionally, a person of ordinary skill in the art would consult the rest of the intrinsic record, including any surrounding claims, the drawings, and the prosecution history—if it is in evidence. Id.; Teleflex, Inc. v. Fisosa N. Am. Corp., 299 F.3d 1313, 1324 (Fed. Cir. 2002). In reading the intrinsic evidence, a person of ordinary skill in the art would give consideration to whether the disputed term is a term commonly used in lay language, a technical term, or a term defined by the patentee.

C. Commonly Used Terms

In some cases, disputed claim language involves a commonly understood term that is readily apparent to the Court. In such a case, the Court considers that a person of ordinary skill in the art would give to it its widely accepted meaning, unless a specialized definition is stated in the patent specification or was stated by the patentee during prosecution of the patent. In articulating the widely accepted meaning of such a term, the Court may consult a general purpose dictionary. Phillips, 415 F.3d at 1314.

D. Technical Terms

If a disputed term is a technical term in the field of the invention, the Court considers that one of skill in the art would give the term its ordinary and customary meaning in that technical field, unless a specialized definition is stated in the specification or during prosecution of the patent. In arriving at this definition, the Court may consult a technical art-specific dictionary or invite the parties to present testimony from experts in the field on the ordinary and customary definition of the technical term at the time of the invention. Id.

E. Defined Terms

The Court acknowledges that a patentee is free to act as his or her own lexicographer. Acting as such, the patentee may use a term differently than a person of ordinary skill in the art would understand it, without the benefit of the patentee's definition. Vitronics Corp., 90 F.3d at 1582. Thus, the Court examines the claims and the intrinsic evidence to determine if the patentee used a term with a specialized meaning.

The Court regards a specialized definition of a term stated in the specification as highly persuasive of the meaning of the term as it is used in a claim. Phillips, 415 F.3d at 1316-17. However, the definition must be stated in a clear words, which make it apparent to the Court that the term has been defined. See id.; Vitronics Corp., 90 F.3d at 1582. If the definition is not clearly stated or cannot be reasonably inferred, the Court may decline to construe the term pending further proceedings. Statements made by the patentee in the prosecution of the patent application as to the scope of the invention may be considered when deciding the meaning of the claims. Microsoft

Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340, 1349 (2004). Accordingly, the Court may also examine the prosecution history of the patent when considering whether to construe the claim term as having a specialized definition.

In construing claims, it is for the Court to determine the terms that require construction and those that do not. See U.S. Surgical Corp. v. Ethicon, Inc.,103 F.3d 1554, 1568 (Fed. Cir. 1997). Moreover, the Court is not required to adopt a construction of a term, even if the parties have stipulated to it. Pfizer, Inc. v. Teva Pharmaceuticals, USA, Inc., 429 F.3d 1364, 1376 (Fed. Cir. 2005). Instead, the Court may arrive at its own constructions of claim terms, which may differ from the constructions proposed by the parties.

In addition to the authorities cited in this Order, the Court will apply the legal standards recited in its previous Claim Construction Orders.

II. DISCUSSION

A. The '992 Patent

1. "transmission system"

Plaintiff moves the Court to reconsider the subsisting definition of the phrase "transmission system"[1] as it is used in Claims 19 and 41.

Claim 19 of the '992 Patent provides:[2]

> A distribution method responsive to requests from a user identifying items in **a transmission system containing information** to be sent **from the transmission system** to receiving systems at remote locations, the method comprising the steps of:

---

[1] In its Third Claim Construction Order dated December 14, 2006, the Court construed the phrase "transmission system" as a coined phrase meaning:

> An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function.

(Third Claim Construction Order at 8, hereafter, "Third Markman," Docket Item No. 216.)

[2] Unless otherwise indicated, all bold typeface is added by the Court to emphasize the terms and phrases under consideration.

> **storing, in the transmission system**, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;
>
> sending a request, by the user **to the transmission system**, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote location selected by the user;
>
> sending at least a portion of the stored information **from the transmission system** to the receiving system at the selected remote location;
>
> receiving the sent information by the receiving system at the selected remote location;
>
> storing a complete copy of the received information in the receiving system at the selected remote location; and
>
> playing back the stored copy of the information using the receiving system at the selected remote location at a time requested by the user.

Claim 41 of the ‘992 atent provides:

A method of transmitting information to remote locations, the transmission method comprising the steps, **performed by a transmission system**, of:

> storing items having information in a source material library;
>
> retrieving the information in the items from the source material library;
>
> assigning a unique identification code to the retrieved information;
>
> placing the retrieved information into a predetermined format as formatted data;
>
> placing the formatted data into a sequence of addressable data blocks;
>
> compressing the formatted and sequenced data blocks;
>
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
>
> sending at least a portion of the file to one of the remote locations.

Since the elements of Claims 19 and 41 require that a step of the patented process be performed on, with or by[3] a "transmission system, the Court has ruled that "transmission system" is a limitation in those elements and must be construed.

The Court begins its consideration of the meaning of "transmission system" as it is used in method Claims 19 and 41, with the recognition that the phrase is used in other claims of the '992 Patent. The subject matter of the '992 Patent is an "Audio and Video Transmission System." The '992 Patent contains numerous independent and dependent claims to a device called a "transmission system." (See e.g., Claims 1-18; 47-53). In addition, the '992 Patent contains numerous process or method claims. (See e.g., Claims 19-24; 41-46; 54-58). Each of the method claims is a new and useful process which is performed on, with, or by the patented "transmission system."[4]

The Court affirms its previous finding that the inventors gave a specialized meaning to the phrase "transmission system." The claims disclose a system which does more than "transmit." In construing both the apparatus and method claims, the Court has determined that the phrase "transmission system" was coined by the inventors to describe a system which stores physical items, extracts information from those items, encodes the information, processes and categorizes it and then stores the information in a form and location accessible to users. In addition, upon request from a user, the "transmission system" transmits information to a remote "receiving system" selected by a user. Thus, the Court has determined that "transmission system" must be construed in a way which recognizes its multiple features and functions.

---

[3] A method in which an apparatus is "used" to perform a function, is different from a method "performed by" an apparatus. In Claims 19 and 41, the "transmission system" is both "used" to perform the method and, itself "performs" some of the steps. Claim 19 recites as a step: "sending a request, by the user to the transmission system. . ." Inherently, in this step, the user is employing or "using" the transmission system as a device to receive the user's request. It is clear from the language of Claims 19 and 41 that the "transmission system" also performs steps to fulfill the purpose of the method.

[4] The '992 Patent repeats the same pattern for a patented apparatus called "receiving system." Claims 25-40 are apparatus claims. Claims 54-58 are method claims which recite steps performed "at the receiving system."

In the written description and drawings, the inventors describe an embodiment of the "transmission system" and "reception system" which enable them to perform the steps of the claims. As to the "transmission system," the written description provides:

> To achieve the objects in accordance with the purposes of the present invention, as embodies and described herein, the **transmission . . . system for providing information to remote locations comprises** source material library means prior to identification and compression; identification encoding means for retrieving the information for the items from the source material library means and for assigning a unique identification code to the retrieved information; conversion means, coupled to identification encoding means, for placing the retrieved information into a predetermined format as formatted data; ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks; compression means, coupled to the ordering means, for compressing the formatted and sequenced data; compressed data storing means, coupled to the compression means, for storing as a file the compressed sequenced data received from the compression means with the unique identification code assigned by the identification encoding means; and transmitter means, coupled to the compressed data storing means, for sending at least portion of a specific file to a specific one of the remote locations.

('992 Patent, Col. 2:25-48.)

The specification discusses the function of the enumerated "means." In some instances the specification describes a known device for performing an enumerated function. For example, the specification describes an: "analog-to-digital converter,"[5] "digital telecine device,"[6] "time encoder,"[7] "apt-s 100 digital audio compression system, manufactured by Audio Porcessing Technology."[8] In other instances, the specification describes the function of a "means" but does not further describe whether the function is performed by hardware, software or a combination.

In the Third Claim Construction Oder, the Court incorporated the "means" nomenclature in defining the components of the "transmission system" of the invention. Plaintiff now seeks clarification as to whether the Court is defining the phrase "transmission system" under §112 ¶ 6.

---

[5] '992 Patent, Col. 7:14.

[6] '992 Patent, Col. 7:38.

[7] '992 Patent, Col. 7:63.

[8] '992 Patent, Col. 9:61-64.

In addition, the Court is asked to reconsider including an enumeration of components in its construction.

Upon reconsideration, the Court finds it necessary to modify its construction. First, the Court clarifies its incorporation of the word "means" in its discussion of "transmission system." Second, the Court clarifies its construction of the phrase "transmission system" and discusses the components of "transmission system" which are necessary to perform the methods claimed in Claims 19 and 41.

a. The use of the word "means" in the specification to identify the components of the patented "transmission system" does not invoke § 112 ¶ 6

In the written description, the inventors describe their "transmission system" and enumerate its components. In naming each component, the inventors use the tag word "means" to signify a physical component or a group of components. To distinguish one component "means" from another, each component "means" is preceded by a modifier: "**source material library** means;" "**identification encoding** means;" "**conversion** means;" "**ordering** means;" "**compression** means;" "**compressed data storing** means;" and "**transmitter** means." In its discussion of the various components of the "transmission system," the Court incorporated the inventors' "means" phraseology in its construction. (See Third Markman at 7.) Although, the Court incorporated the inventors' tag word "means," the Court now finds that the claim construction under § 112 ¶ 6 is inappropriate because neither Claims 19 nor Claim 41 contain means-plus-function or step-plus-function claim elements.[9]

---

[9] "Means-plus-function" claim construction is invoked in a case in which the Court is called upon to construe a patent claim to an apparatus (or method), in which an element of the claim is written in "means-plus-function" format. When construing a claim limitation that is written in "means-plus-function" format, the Court first must identify the function of the claim limitation and then it must consult the specification to attempt to identify the corresponding structure which performs that function. If the specification discloses a structure, and clearly links that structure to the function recited in the claim, the Court would construe the element as limited to the identified structure and its equivalents. See Micro Chemical, Inc. v. Great Plains Chemical Co., Inc., 194 F.3d 1250, 1258 (Fed. Cir. 1999).

b. The phrase "transmission system" means the patented apparatus described in the specification, including its inherent interoperability

Both Claims 19 and 41 disclose a structure, i.e., a "transmission system" which is used to perform the method.[10] Since the claims require that a step be performed by or with a transmission system," it becomes necessary to define the phrase. Specifically, the parties request clarification whether the Court's construction of "transmission system" means the entire "transmission system" (i.e., all enumerated components in the specification) or whether the definition of the phrase is to be modified as to each method claim depending upon the steps of the method.

As a matter of law, if in the preamble or in steps of a method claim the inventors specify that the method is performed by or with a particular apparatus, the disclosed apparatus is a limitation of the claim. Bell Communication Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619 (Fed. Cir. 1995).

In this case, the Preamble and particular steps of Claims 19 and 41 recite that the method is performed by or with a "transmission system." However, incorporation of the "transmission system" also incorporates the inherent operability of the system, which affects which components are "essential." For example, the written description and the drawings describe three aspects of the "transmission system" which affect which components are essential: (a) cooperative relationship between and among components, (b) optional components and (c) components necessary to respond to or perform the steps of a particular claim. Below, the Court uses the block diagrams and passages of the written description to illustrate how these aspects affect the claim construction.

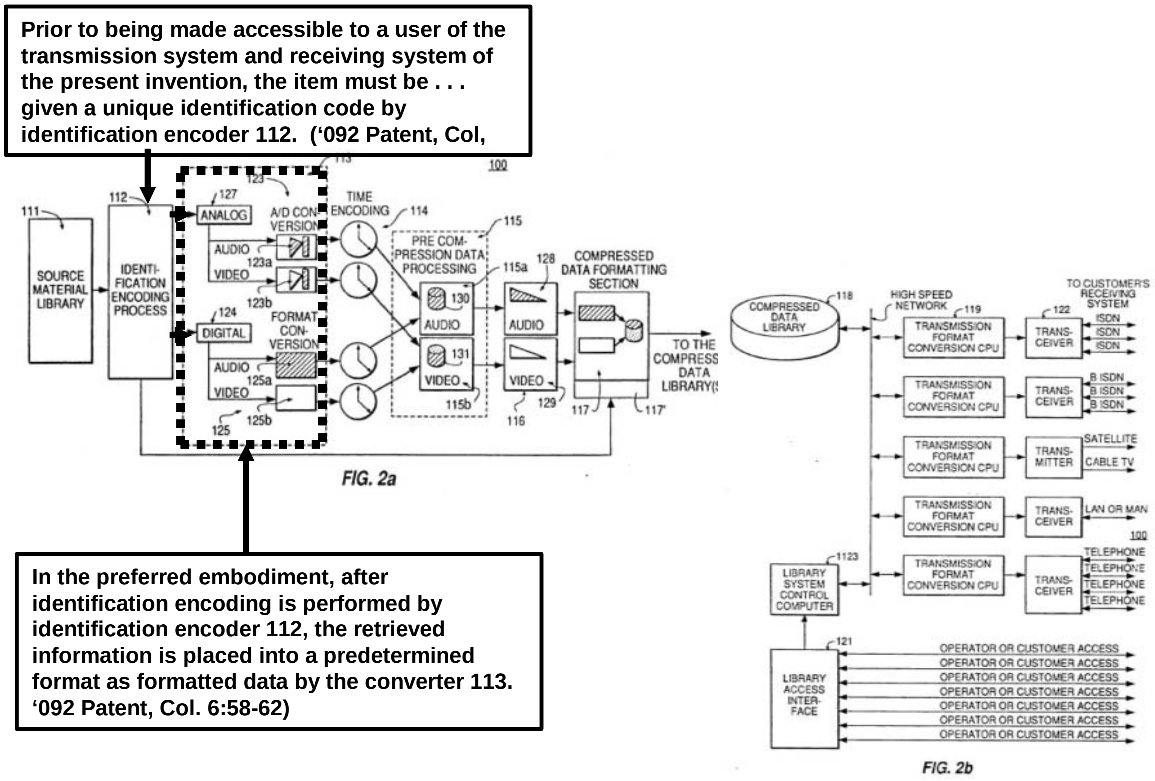
i. cooperative relationship between and among the components

In the claims, written description, and the drawings of the '992 Patent, the inventors indicated cooperative relationships between interconnected components of the "transmission system." A person of skill in the art would have understood from the written description and the

[10] Although the Court does not analyze the function of each component in deciding whether to include it in a construction of "transmission system," functionality of a component is not wholly irrelevant. Functionality may be considered to determine if a component is or is not includable to perform the steps of a method. In addition, functionality of a component may be an issue if objections to patentability are raised during post-construction proceedings.

drawings that information flows from one component or set of components to another. For example, the cooperative relationship between the block entitled "Identification Encoding Process" and other components is illustrated below:

ILLUSTRATION OF
COOPERATIVE RELATIONSHIP
BETWEEN COMPONENTS


Prior to being made accessible to a user of the transmission system and receiving system of the present invention, the item must be . . . given a unique identification code by identification encoder 112. ('092 Patent, Col,
In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113. '092 Patent, Col. 6:58-62)
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
ANALOG
DIGITAL
A/D CON-VERSION
FORMAT CON-VERSION
TIME ENCODING
PRE COM-PRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
TO THE COMPRESSED DATA LIBRARY
FIG. 2a
COMPRESSED DATA LIBRARY
HIGH SPEED NETWORK
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TRANS-MITTER
TO CUSTOMER'S RECEIVING SYSTEM
SATELLITE
CABLE TV
LAN OR MAN
TELEPHONE
LIBRARY SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
FIG. 2b

Thus, the determination of which components of the "transmission system" are "essential" for a particular claim must take into account the structural and functional relationship between and among components as described in the specification.

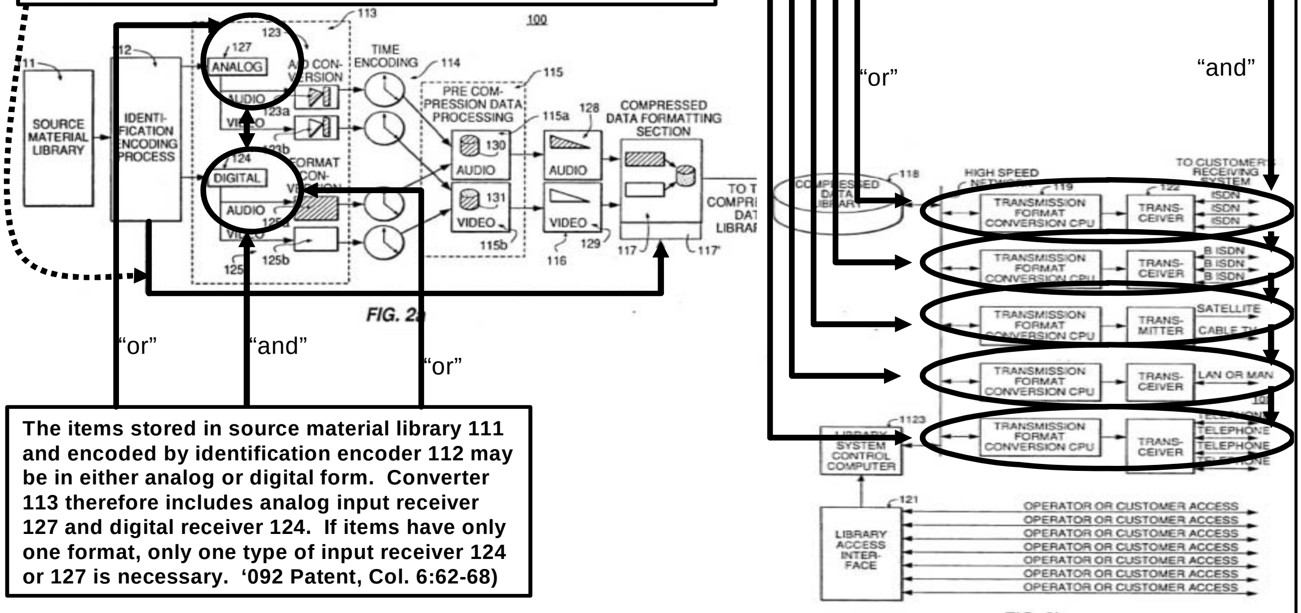
ii. optional components

A skilled artisan at the time of the invention would have understood that the inventors devised a "transmission system" which has optional components, depending, for example, upon the nature of the information, the user's request and the type of receiving system which the user selects. The optional nature of the components of the system are illustrated below:

ILLUSTRATION OF IDENTIFYING COMPONENTS WHICH ARE OPTIONAL

In some cases, such as inter-library transfers, incoming materials may be in a previously compressed form so that there is no need to perform compression by precompression processor 115 and compressors 128 and 129. In such a case, retrieved items are passed directly from identification 112 to the compressed data formatter 117. ('092 Patent, Col. 7:44-50).

"In a preferred embodiment of the present invention, many forms of communication channels may be employed. Distribution of information is by common carrier communication channels whenever possible. These channels include common telephone service, ISDN and Broadband ISDN, DBS, cable television, microwave and MAN. ('092 Patent, Col. 16:63-68)


"or"
"and"
"or"
"and"
"or"
SOURCE MATERIAL LIBRARY
IDENTIFICATION ENCODING PROCESS
ANALOG
DIGITAL
AUDIO
VIDEO
TIME ENCODING
PRE COMPRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
HIGH SPEED NETWORK
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TRANS-MITTER
ISDN
B ISDN
SATELLITE
LAN OR MAN
TELEPHONE
TO CUSTOMER RECEIVING SYSTEM
SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTERFACE
OPERATOR OR CUSTOMER ACCESS
FIG. 2a FIG. 2b

The items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form. Converter 113 therefore includes analog input receiver 127 and digital receiver 124. If items have only one format, only one type of input receiver 124 or 127 is necessary. '092 Patent, Col. 6:62-68)

A skilled artisan at the time of the invention would have understood that the "transmission system" contains components for processing, for example, **digital audio information** which are separate and distinct from those for processing **analog video information**. Similarly, information from the block labeled "Identification Encoding Process" could **optionally** be passed to either Block 113 or to Block 117 or to both, depending upon the nature of the information being processed.

Thus, the determination of which components of the "transmission system" are "essential" is affected by whether the step which is being performed on or with the system is broad or limited in scope.

iii. components necessary to respond to the steps of the claim

To meet the "transmission system" limitation of a step, an apparatus must contain the component or components necessary to perform that step. Below, the Court illustrates components which are responsive to some of the steps of Claim 19:

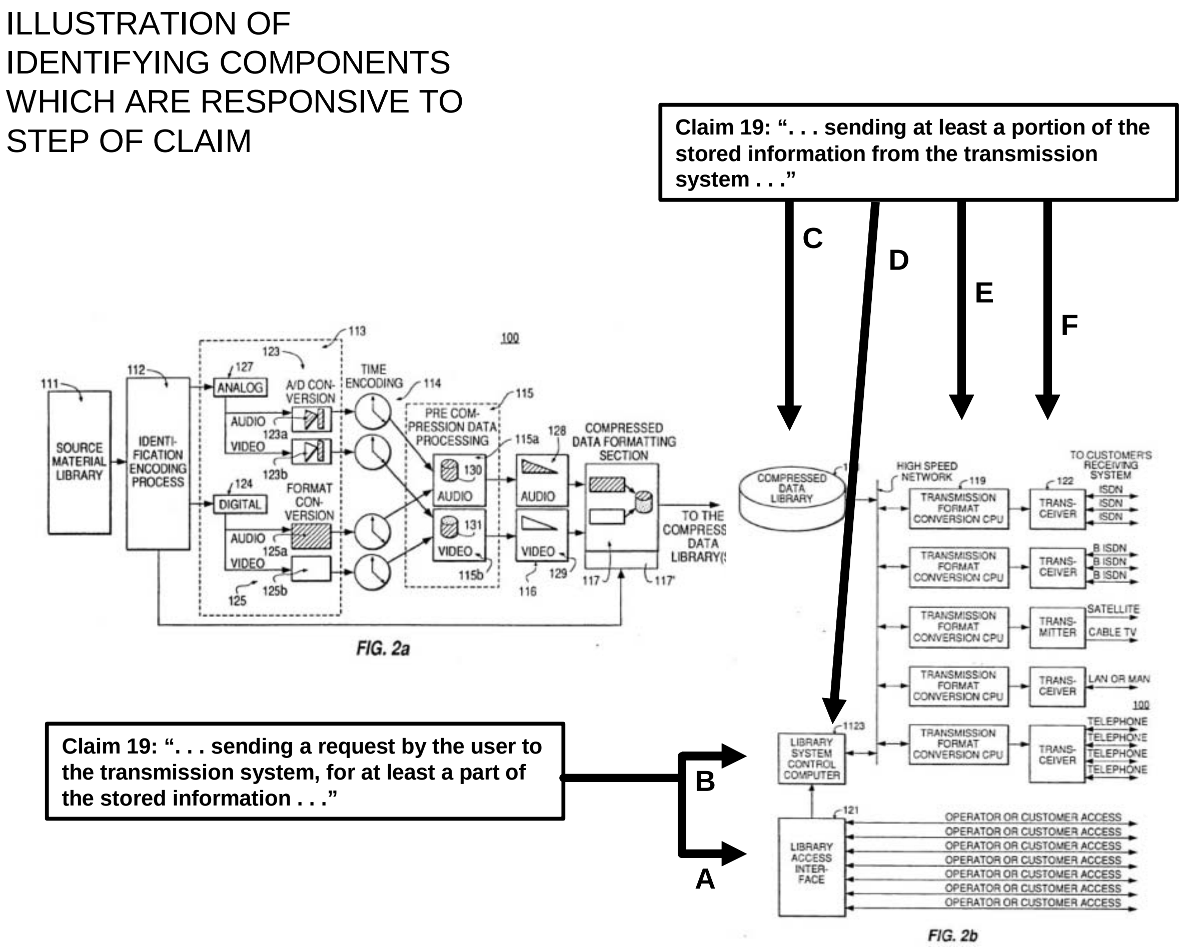


ILLUSTRATION OF
IDENTIFYING COMPONENTS
WHICH ARE RESPONSIVE TO
STEP OF CLAIM
Claim 19: ". . . sending at least a portion of the stored information from the transmission system . . ."
C
D
E
F
Claim 19: ". . . sending a request by the user to the transmission system, for at least a part of the stored information . . ."
B
A
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
ANALOG
DIGITAL
AUDIO
VIDEO
A/D CON-VERSION
FORMAT CON-VERSION
TIME ENCODING
PRE COM-PRESSION DATA PROCESSING
COMPRESSED DATA FORMATTING SECTION
TO THE COMPRESSED DATA LIBRARY
FIG. 2a
COMPRESSED DATA LIBRARY
HIGH SPEED NETWORK
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TRANS-MITTER
TO CUSTOMER'S RECEIVING SYSTEM
ISDN
B ISDN
SATELLITE
CABLE TV
LAN OR MAN
TELEPHONE
LIBRARY SYSTEM CONTROL COMPUTER
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
FIG. 2b

The Third Claim Construction Order's definition of "transmission system" includes an enumeration of components determined by the Court to be essential. The Court now finds that there are additional components which are essential, depending upon the steps of a particular claim. For example, the current definition omits the components entitled "Library Access Interface" and the "Library System Control Computer," which are essential to allow the "transmission system" to perform the following step of Claim 19:

sending a request by the user to the transmission system, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote locations selected by the user[.]

Rather than list the "essential" components of a "transmission system" for each method claim, the Court vacates its previous definition. The Court now adopts a definition of "transmission system" which applies to all method claims and which recognizes its inherent interoperability of the system. Accordingly, as used in Claims 19 and 41 of the '992 Patent, the Court now construes the phrase **"transmission system"** to mean:

the transmission system of the present invention as described in the specification, comprising all necessary components to perform each step required to be performed by, on, or with a transmission system. With respect to Claim 19, the following components are necessary to perform the following steps:[11]

b. Request for submission from the parties of enumeration of essential components

As discussed in footnote 11, the Court intends to include in its construction of "transmission system" a description of each component or group of components which is necessary to perform each step of each asserted method claim.[12] However, to avoid further controversy, the Court invites the parties to submit their proposed list of which components are necessary to perform each step. The submitted enumeration must be based on the above construction of the phrase "transmission system" and take into consideration cooperative relationships, optional components and the steps of each claim.

//

[11] The Court intends to insert a listing of essential components.

[12] In addition, the issue of which components are essential is deferred until the Court is called upon to determine whether an alleged infringer is using a "transmission system" to perform a step which Claims 19 or 41 require be performed by or on a "transmission system."

The memorandum must be accompanied by a Chart in the following format:

Patent '000 Claim No.	**Patent Claim language**	**Component necessary to perform step**	**Supporting reference(s) from specification**	**Commentary**
'092, Claim 19 step 4	". . .sending at least a portion of the stored information from the transmission system. . ."	Components described in the specification and illustrated by Block Diagram 2b, labeled 118, 119, 122	"In a preferred embodiment of the present invention, many forms of communication channels may be employed. . .('092, Col. 16:63-68)	The Block Diagram shows alternative structures. One or all of them may be necessary depending upon . . . [See Section II in the attached Memorandum of Law]
'092, Claim 19 step 5				
'092, Claim 19 step 6				

2. "receiving system"

The claim construction analysis with respect to "transmission system" applies equally to the phrase "receiving system." Accordingly, the Court vacates its previous construction and now construes the phrase "**receiving system**" as used in Claim 19 of the '992 Patent to mean:

> **the receiving system of the present invention as described in the specification, comprising all necessary components to perform each step required to be performed by, on, or with a receiving system.**

As with "transmission system," the Court intends to include a description of the necessary components in its Claim Construction. The Court invites the parties to submit their proposed list of which components are necessary to perform the steps of Claim 19 on, with or by a "receiving system." The submission must include supporting memorandum and the Chart as outlined above.

3. "sequence of addressable data blocks"

The Court declines to modify its previously construction of the phrase, "sequence of addressable data blocks."

4. "storing"

The Court has been requested to reconsider its construction of the word "storing" as used in Claim 41, which provides:

> A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:
>
> storing items having information in a source material library;

In the Third Claim Construction Order, the Court construed the phrase "storing items having information in a source material library" to mean "placing physical items containing audio information or video information or both into a collection or original sources of information." (Third Markman at 30.) The Court has been persuaded to reconsider its construction.

Claim 41 recites "storing" items in a source material library as the first step in the process. The Preamble requires that "storing" be "performed by the transmission system." The issue is whether the word "storing" should be construed to mean that the transmission system performs a manipulative step of "placing" items into the source material library, or whether the word should be construed to mean that the transmission system performs the step by "retaining" the items in the source material library. Plaintiff now requests that the Court re-interpret "storing" to mean "retaining." Plaintiff contends that both interpretations are supported by the plain ordinary meaning and use of the word "storing," but that "retaining" is the only interpretation which is supported by the specification.[13]

The words "to store" and "storing" are commonly used words with plain and ordinary meanings. Among others, the act of "storing items" means placing the items in a location."[14] See WEBSTER'S NEW TWENTIETH CENTURY DICTIONARY, 1796 (2d ed. 1983). However, as pointed out by Plaintiff, another interpretation of "storing items" is "retaining items." The "placing" interpretation is appropriate when the phrase "storing items" is being used to describe the act of putting the items in a location. The "retaining" interpretation is appropriate when the phrase "storing items" is used to describe holding the items secure or intact in a place or condition.

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[13] During the course of the litigation, Plaintiff has asserted various constructions of the term. Plaintiff is once again asking the Court to construe "storing" to mean "retaining."

[14] For the reasons stated in its Third Claim Construction Order, this was the interpretation used by the Court.

The process of placing items in a location and retaining items are sufficiently different from each other as to make it important to determine which process was meant by the inventors. In making a determination of which interpretation to adopt, the Court notes that the phrase is used in a step of a method claim. Although it might be subject to limitations, a step in a method claim must be an act performed by an actor on a workpiece:[15]

> A very important rule to remember is that the "elements" of a method claim instead of being structural parts, are, and must be, acts or manipulative steps that are performed upon an article, workpiece or chemical substance.

5 ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING, 4-2 (2006).

Either interpretation of "storing items" ("placing" the items in a location or "retaining" the items in a location or condition) is a manipulative step. The Preamble of Claim 41 expressly provides that each step, including the step of "storing" must be performed by the "transmission system." Thus, under either interpretation, in performing the step of "storing" the "transmission system" is acting on a workpiece (items).

Upon reconsideration, the Court has determined that the interpretation of "storing items" to mean "placing items" is problematic because the specification does not contain any description of how the transmission system places items into the system. On the other hand, a person of skill in the art reading the specification at the time of the invention, might find support in the specification for interpreting "storing items" to mean "retaining items,"[16] because the specification discloses a component of the "transmission system," i.e., the "source material library" as a component which holds items. Thus, there is a basis for a skilled artisan to determine that when the inventors claimed a process in which the "transmission system" performs the step of "storing items having information in a source material library," the inventors might have meant that the "transmission system" was "retaining the items" in the source material library. At this point, the Court does not decide nor does Plaintiff point out what disclosed features of the "transmission system" enable it to perform "retaining" activity.[17] The Court leaves enablement or definiteness for consideration later if a motion addressing the issue is brought before the Court.

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[15] Plaintiff objects to this proposition. To support its position that elements of process claims need not be manipulative steps, Plaintiff contends that the step of "leaving" baked goods in an oven is not manipulative. The Court rejects Plaintiff's hypothetical as illustrative of non-manipulative conduct. A manipulative step is a step in a process performed by an actor upon a workpiece. If the actor in Plaintiff's hypothetical "leaves" an item in a oven for a period of time during the baking process, active conduct is being performed.

[16] When possible claim language should be construed to preserve validity of the claim. See Texas Instruments v. U.S. International Trade Commission, 871 F.2d 1054 (Fed. Cir. 1989).

Accordingly, the Court vacates its construction of the phrase "storing items having information" in its Third Claim Construction Order.

The Court now construes the phrase "storing items having information" to mean:

an act performed by the "transmission system" of retaining physical items containing audio information or video information or both as a collection of original sources of information in the source material library.

B. Additional Briefing Regarding Claim 45 of the '992 Patent

In the Third Claim Construction Order, the Court declined to construe the meaning of the phrase "separately storing a plurality of files" as it is used in dependent Claim 45 of the '992 Patent. In their memorandum regarding the present motions, the parties have addressed the Court's declination to construe Claim 45. However, no formal motion is made by either party with respect to the matter. Accordingly, the Court declines to take any action with respect to Claim 45 at this time.

C. Disposition of Pending Motions

Previously, Plaintiff filed a Motion for Entry of Judgment of Non-Infringement and Invalidity for Indefiniteness of U.S. Patent No. 6,144,702 and for Certification Pursuant to Federal Rule of Civil Procedure 54(b) in which Defendants opposed. (See Docket Item Nos. 121, 133.) Since the motion was made prior to completion of claim construction, it is DENIED without prejudice to being renewed upon completion of claim construction.

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[17] The specification is silent as to what component of the "transmission system" is capable of performing the "retaining" step. With respect to storing physical items having information, the only component discussed in the specification is the "source material library" itself. However, the "source material library" is only described as containing a collection of items having information. See e.g., '992 Patent, Col. 6:8-22.

In addition, Defendants Comcast Cable Communications, LLC and Insight Communications, Inc. filed a Motion for Partial Summary Judgment of Invalidity and Non-Infringement of all Claims of the '702 Patent. (See Docket No. 149). Since the motion was made prior to completion of claim construction, it is DENIED without prejudice to being renewed upon completion of claim construction.

III. CONCLUSION

In this Order, the Court has confirmed, vacated and modified its previous constructions. The Court has also indicated that it intends to modify its construction of the phrases "transmission system" and "receiving system" by adding components that are necessary to perform each step. Any party wishing to submit a proposed construction shall file their memorandum as described in this Order by **November 2, 2007**.

Dated: October 19, 2007

JAMES WARE
United States District Judge

THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:

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Dated: October 19, 2007

Richard W. Wieking, Clerk

By: /s/ JW Chambers
Elizabeth Garcia
Courtroom Deputy